SUPREME COURT, U.S.

Supreme Court, U.S.
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E. ROBERT SEAVER, CLERK

IN THE

Supreme Court of the United States

October Term, 1970.

No. 1064

STAHLIN BROS. FIBRE WORKS, INC.,
Petitioner,

vs.

PANDUIT CORPORATION,
Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT.

JOHN D. SIMPSON,
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STAHLIN BROS. FIBRE WORKS, INC.,

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vs.

PANDUIT CORPORATION,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT.

Your Petitioner, Stahlin Bros. Fibre Works, Inc. hereby petitions that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the Sixth Circuit dated August 7, 1970, rehearing denied September 8, 1970, affirming the decision of the United States District Court for the Western District of Michigan, Southern Division.

OPINIONS BELOW.

The opinion of the Court of Appeals, affirming the judgment of the District Court on validity is printed in Appendix A hereto and is reported at 166 USPQ 524. The judgment entered by the Court of Appeals appears in

Appendix B. The opinion of the Court of Appeals denying petitioner's Request for Rehearing is printed in Appendix E hereto and is not yet reported in the official reports. The opinion of the District Court for the Western District of Michigan, Southern Division, holding Plaintiff's patent valid and infringed is printed in Appendix C to this Petition and is reported at 298 F. Supp. 435 and 162 USPQ 114. The judgment entered by the District Court is printed in Appendix D. Petitioner appealed to the Court of Appeals for the Sixth Circuit only from the judgment of the District Court sustaining validity of the patent.

JURISDICTION.

The judgment of the Court of Appeals was entered on August 7, 1970 and Rehearing was denied on September 8, 1970. Jurisdiction of this Court is invoked under 28 USC § 1254(1). The jurisdiction of the District Court was based on 28 USC § 1338.

Exercise by this Court of its jurisdiction prerogative is solicited in the public interest since the decisions below have neglected the mandates of the Supreme Court on the Constitutional standard of patentability. The decisions resulted in part from evidentiary rulings in the District Court in derogation of the minimal standards of due process and fundamental fairness.

QUESTIONS PRESENTED.

I.

Whether in the design of a plastic wiring duct wall (the purpose of which is to facilitate distribution of a multiplicity of electrical wires) it shall be considered a patentable advance in the art to proceed from an acknowledged prior art duct wall having holes or openings with rounded sides as follows:

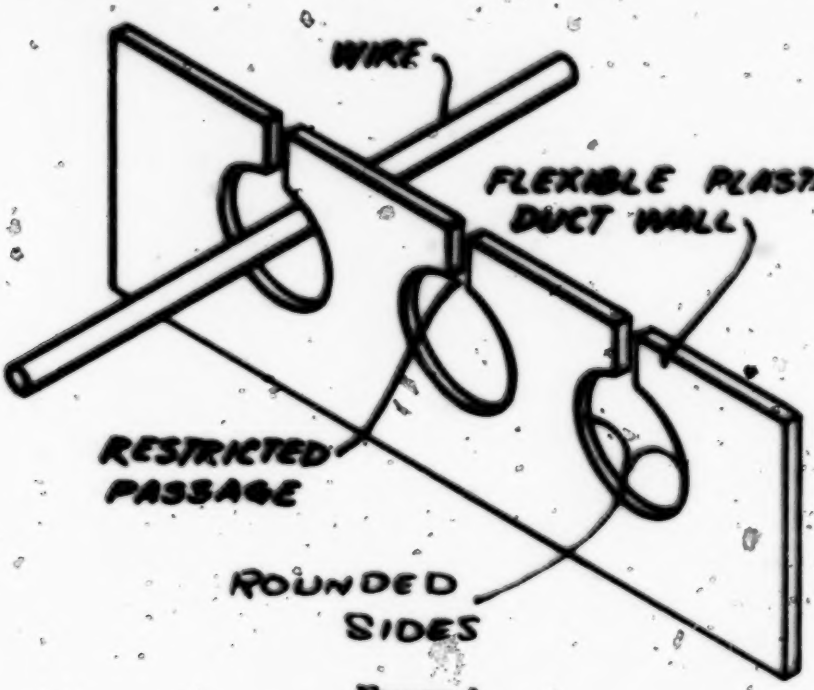

FIGURE 1.

to a duct wall having holes with flattened sides as follows:

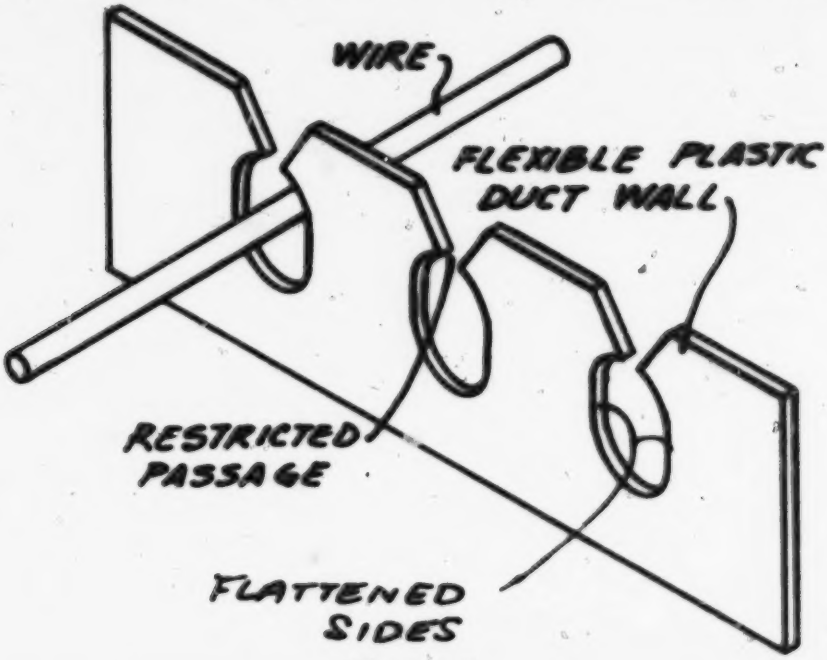

FIGURE 2.

where the Patent Office predicated patentability on the recitation of a restricted passage into the holes and not on the shape of the edges of the holes, and where in each device above the purpose of the restricted passage (having a width less than the thickness of the wire) was to prevent wires from accidentally falling out of the holes.

II.

Can the validity of a patent be sustained on the basis of an "afterthought" function where no such function is hinted in the specification of the patent.

III.

Is it prejudicial error and a violation of due process for the District Court to refuse to allow Defendant to use documentary material to impeach the testimony of the

patent owner's principal witness, on the ground that such documentary material had not been marked as an exhibit at pretrial.

IV.

Did the District Court err in holding that there was contributory infringement by one of the Defendant's products when there was no evidence of direct infringement adduced at trial.

CONSTITUTIONAL AND STATUTORY PROVISIONS AND COURT RULES.

The questions presented rest upon the Due Process Clause of the Fifth Amendment to the Constitution, the Patent Statutes, U. S. Code, Title 35, Sections 102, 103, 271; and the Pretrial Order of the District Court of the Western District of Michigan. Those portions of the foregoing upon which Petitioners rely are printed in Appendix F.

STATEMENT OF THE CASE AND REASONS FOR GRANTING THE WRIT.

Question I.

An understanding may be had of the subject matter of the suit and of the legal principles involved as well as the compelling reasons in the public interest for granting the writ by reference to the following questions presented for the Court's consideration.

The most startling thing about this case is the fact that it had to be litigated all the way to the United States Supreme Court. It is incredible that the prior mandates of the Supreme Court have been so neglected.

What could be less of a patentable advance than putting straight sides on round holes in order to get the holes closer together.

If there is ever going to be an ideal opportunity for the Supreme Court to lay down a mandate that will put our Patent system in its proper historical perspective, this must be it.

These are the types of patents on ridiculously simple devices which the Supreme Court has had to invalidate in the past.

1. **A rubber slot in the end of a wood pencil to serve as an eraser. (*Reckendorfer* v. *Faber*, 92 U. S. 347.)**
2. **Fine thread across open squares in a regular hair-net to keep hair in place more effectively. (*Dalton* v. *Jennings*, 93 U. S. 271.)**
3. **A stamp for impressing initials in the side of a plug of tobacco. (*Miller* v. *Force*, 116 U. S. 22.)**
4. **A hose reel or large diameter so that water will flow through the hose while it is wound on the reel. (*Preston* v. *Manard*, 116 U. S. 661.)**
5. **Putting rollers on a machine to make it movable. (*Hendy* v. *Miners' Iron Works*, 127 U. S. 370.)**
6. **Using flat cord instead of round cord for the loop at the end of suspenders. (*Sheufield* v. *Nashawannuck Mfg. Co.*, 137 U. S. 56.)**
7. **Bridging a strip of cloth across the fly of pantaloons to reinforce them against tearing. (*Patent Clothing Co.* v. *Glover*, 141 U. S. 560.)**
8. **Placing rubber hand grips on bicycle handelbars. (*Pope Mfg. Co.* v. *Gormully Mfg. Co.*, 144 U. S. 238.)**
9. **An oval rather than a round toilet paper roll. (*Morgan Envelope Co.* v. *Albany Perforated Wrapping Paper Co.*, 152 U. S. 425.)**

To flatten the sides on round holes which merely hold a wire in place in order to move them closer together belongs in this list. The present device is the simplest device that ever could conceivably be involved in a patent case. It makes a mockery of our industrial heritage to have one,

let alone two of our Federal Courts raise this device to the dignity of a patentable invention.

This device has no moving parts; it's a simple plastic stamping. No more ideal situation could exist for the Supreme Court to lay down a mandate once and for all.

What could be more appropriate than Thomas Jefferson's comment quoted by Mr. Justice Clark in *Graham* v. *John Deere:*

> "A mere change of form should give no right to a patent, as a high quartered shoe instead of a low one: a round hat instead of a three square, or *a square bucket instead of a round one.*" 383 U. S. 1, n. 3, 148 USPQ 459, 464 (Emphasis supplied).

Question II.

The plastic stamping which is the patented device (Figure 2) has an opening or slot at the top of each hole which is narrower than the thickness of the wire to prevent the wire from falling out. The attorneys argued the patentability of this feature in the Patent Office and since the Patent Examiner could not find this feature in the prior art, he allowed the patent.

Defendant-Petitioner Found Just Such Anticipatory Prior Art (Figure 1).

Wire frames or ducts had been built, sold, used, and advertised long prior to the patent applicant's invention, which had restricted slots or passages leading into holes with flexible fingers between the holes to aid in the insertion and retention of a wire. Only one difference existed between this prior art duct and the patented duct. The patented duct had flat sided holes—the prior art duct had round sided holes.

Plaintiff then fabricated its "afterthought" that im-

portance lay in the fact that the holes in its duct were flat sided rather than round sided.

This Court commented on such afterthoughts in its recent case of *Graham* v. *John Deere*, 383 U. S. 1 at 25 as follows:

> "Petitioners' argument basing validity on the free-flex theory raised for the first time on appeal is reminiscent of *Lincoln Engineering Co.* v. *Stewart-Warner Corp.*, 303 U. S. 545 (1938), where the Court called such an effort 'an afterthought'. No such function . . . is hinted at in the specifications of the patent. If this were so vital an element in the functioning of the apparatus it is strange that all mention of it was omitted."

The fact that the lower courts in this case have upheld the patentability of these holes with flat sides over the prior art holes with round sides is in itself a neglect of the prior mandates of the Supreme Court, but to have done so as the result of the patentee's "afterthought" is tantamount to a failure to respond to the Supreme Court's directives defining patentability.

The Sixth Circuit needs guidance from the Supreme Court if any reasonable level of patentability is to be maintained in that circuit.

Question III.

In an effort to breathe life into its argument that flat sided holes constitute a patentable advance over the nearly identical round sided holes, Plaintiff created the argument that the round sided holes would not perform as satisfactorily if circuit wires were wired *taut* in the ducts. This position was first taken by Plaintiff in this case at *trial* itself.

Plaintiff produced a witness (president of Plaintiff Company itself) to lend credence to this theory by testifying

that ducts were normally wired tautly and when so wired, the flat sided duct had an advantage over the round holed duct.

Defendant had in its possession a catalog produced by Plaintiff Company which illustrated *loosely* wired ducts as being *typical* and even so captioned its catalog illustrations. Such evidence would have impeached the witness's testimony.

The Court refused to allow Defendant to use the catalog to impeach the witness on the sole ground that the catalog had not been marked as an exhibit before trial.

Due Process requires fundamental fairness (*In re Murchison*, 349 U. S. 133, 1955) and at its very least should permit impeachment of a witness without any such limitation on the use of impeaching documents as was imposed by the District Court in this case.

Question IV.

Can Defendant be charged with contributory infringement and/or with inducement to infringe in the absence of a showing of any actual infringement by another? If the lower Courts' affirmative answer to that question is allowed to stand it runs exactly contrary to the long established principle of the Supreme Court as stated in *Aro Mfg. Co. Inc.* v. *Convertible Top Replacement Co. Inc.*, 365 U. S. 336, 341:

> "... it is settled that if there is no direct infringement of a patent there can be no contributory infringement. In *Mercoid* v. *Mid-Continent*, it was said: 'In a word, if there is no infringement of a patent there can be no contributory infringer,' 320 U. S. 661, 677, and that 'if the purchaser and user could not be amerced as an infringer certainly one who sold to him ... cannot be amerced for contributing to a non-existent infringement.' Id., at 674."

The single patent claim at issue called for a device such as is shown in Figure 2 of this Petition with restricted passages leading into the holes. One of Defendant's ducts (its so-called Web-Slot duct) has a continuous rib running along the upper edge of the wall closing the passages leading into the holes.

Defendant offered evidence that prior to the date of issuance of the patent Defendant had suggested a modification in the duct which would have converted it to an open slotted duct such as is shown in Figure 2. That was twelve years ago. No evidence was offered at trial that any such suggestions had been made since the issuance of the patent, and in fact no evidence was offered that any such ducts have been so modified since the issuance of the patent.

Infringement cannot be hypothesized. It either exists in fact or it does not. Where there has been no direct infringement and no evidence tending to establish direct infringement, there can be no contributory infringement under the *Aro* case.

CONCLUSION.

Wherefore your petitioner prays that a Writ of Certiorari issue to the Court of Appeals for the Sixth Circuit to the end that this cause may be reviewed and determined by this Court, that the judgment of the Court of Appeals for the Sixth Circuit holding the Walch patent valid and infringed and enforceable be reversed; and that your petitioner be granted due process, and such other and further relief in the premises as may be just and proper.

Respectfully submitted,

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APPENDIX A.

No. 19786.

UNITED STATES COURT OF APPEALS

For the Sixth Circuit.

PANDUIT CORPORATION, *Plaintiff-Appellee,* v. STAHLIN BROS. FIBRE WORKS, INC., *Defendant-Appellant.*	Appeal from the United States District Court for the Western District of Michigan, Southern Division.

Decided and Filed August 7, 1970.

Before: WEICK, EDWARDS, and CELEBREZZE, *Circuit Judges.*

CELEBREZZE, *Circuit Judge.* This is an appeal from an order of the United States District Court for the Western District of Michigan, Southern Division, holding a patent on an electrical wiring duct owned by the Panduit Corporation, U. S. Patent No. 3,024,301, issued on March 6, 1962 to K. R. Walch [hereinafter the "Walch" patent], valid and infringed by two devices manufactured by Stahlin Bros. Fibre Works, Inc. 35 U. S. C. §§ 101, 102, 103 (1964). Stahlin Bros. appeals, asserting various errors of fact, procedure, and law.

The patent in suit is on a rack for supporting, orienting and arranging wires in electrical circuits. Similar devices are reasonably familiar: they are commonly used to support

and arrange wires in radios, phonographs, televisions, and other electrical circuits. The patent was awarded to Walch, an employee of the General Electric Company, after an interference proceeding in the patent office between Walch and Mr. Jack E. Caveney, president of the Panduit Corporation, whose application on a similar rack, the "Panduit Duct," was filed shortly after the Walch application. Claim 5 of the Walch patent, the only claim in issue in the instant proceedings, was the claim in interference on which Walch was awarded priority of invention. Subsequent to the issuance of the patent to Walch, Panduit Corporation purchased the Walch patent from General Electric.

Claim 5 provides:

> "5. A wall for supporting and orienting wires comprising a side wall having longitudinally spaced substantially parallel slits open at one edge of said wall and defining substantially parallel edges on longitudinally spaced fingers, the free ends of said fingers being enlarged to narrow the outer ends of the slits and provide restricted passages for the wires between the finger ends and thereby prevent accidental removal of the wires from between the fingers, said fingers being flexible to permit their deflection and provide wider spacing at their free ends to facilitate positioning and removal of wires between said fingers."

Restated, claim 5 described a wiring duct composed of a strip of material (plastic wood, metal, etc.) with one or two rows of flexible, perpendicular, finger-like projections (the "side walls") attached to its edge or edges. The fingers are spaced evenly apart, the distance between two adjacent fingers on the same side of the strip being roughly equal to the diameter of wires being carried through the duct. Wires being carried through the duct enter and leave through

these "substantially parallel slits" between the fingers. To prevent slippage or accidental removal of wires passing between adjacent fingers, the free ends of the fingers are enlarged into knobs; consequently, the distance between adjacent fingers at their free ends may be somewhat less than the diameter of wires passing between them. Being flexible, the fingers may be bent toward or away from the backing strip to provide wider spacing at the free ends of the fingers, and facilitate placement, positioning, and removal of wires.

Prior to 1955, the year Walch filed his patent application, several techniques and devices were used to order and arrange wires in electrical circuits, or electrical control panels. The "flat wiring" method, for example, did not require the use of ducts: wires were simply laid flat against the back wall of the control panel. The "tied" or "laced" cable method, similarly, did not require the use of special ducts: wires between electrical components were installed loosely in the electrical control panel and then laced together with ties. Although both these methods, "flat wiring" and "laced" cable, were in common use in the late 1920's, each had drawbacks that were well recognized by industry people. Consequently, between 1930 and 1955, a spate of patents were acquired on various types of wiring ducts. One acquired by General Electric in the 1930's, for example, was a three-sided metal duct with perforated round holes in its side walls. Wires carried through the duct entered and left through these holes, through which they had to be threaded. U. S. Patent No. 2,006,0150. This duct, as all others with holes in their side walls, had the disadvantage that wires could not be removed from the duct, or repositioned within it, unless they were first disconnected from the components they connected, and threaded back through

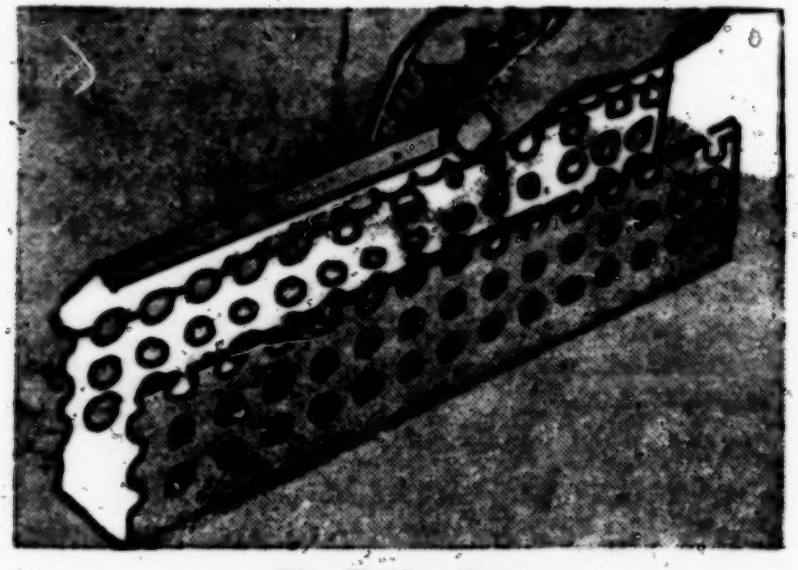
the holes. The District Court found, from substantially undisputed testimony, that a wire near the bottom of such a duct could often not be removed from it unless the wires above it were also removed. Round hole ducts had the added disadvantage that, being inaccessible, wires could not be traced to their origin or rearranged in the control panel without dis-assembling it.

At trial, Stahlin Bros. tested the validity of the Walch patent against two such prior art devices which had not been before the patent office, notwithstanding its seven searches: the Taylor duct and the Franz patent, U. S. Pat. No. 2,712,916.

The Taylor duct is a three-sided duct made of a "rigid thermo-plastic" material, according to the Taylor Electric Company brochures describing it. The Taylor duct has rows of holes in its side walls, the number of rows varying depending upon whether the customer selects a one-inch or four-inch high duct, or some intermediate size. The higher the side wall, the greater the number of holes. Slits from the top of the side wall to the top row of holes form apertures. The side wall between these apertures may be deflected in much the same way as the fingers of the Walch device to increase the size of the aperture and allow for easier placement of wires into the top row of holes. In all but the one-inch high duct, there are more than one row of holes, and the holes in the bottom row, or rows (there may be as many as three rows), are closed. The only way wire can be placed in these lower holes is to thread it through the side wall.

At trial, Stahlin Bros. emphasized most greatly the similarities between the one-inch high Taylor duct and the Walch device. It introduced various testimony and exhibits tending to show that the material between the holes in the side walls of the Taylor device could be deflected much in

the same way as the fingers of the Walch device to facilitate placement of wires into the holes.



The Taylor Duct

(Photograph from an advertisement appearing in a May, 1954 issue of "Electrical Equipment Magazine." Slightly retouched for clarity.)

Panduit Corporation, on the other hand, emphasized that even if the material between the holes in Taylor could be considered "fingers," the convex crescents on the sides of that material were not "substantially parallel." The effect of this was that wires placed into the Taylor duct, and strung tightly through the holes in the side walls, could not be removed simply by deflecting the "fingers." Such wires, according to Panduit's evidence, would be trapped in the crescent-shaped side of the holes in the side wall.

The Walch Duct.

(Figures 1 and 2 from the Walch patent. These figures illustrate Walch's early model, employing a wood backing strip and wire fingers. The patent office and the District Court[1] held that later models, with solid molded plastic fingers and backing strips, were substantively identical. We affirm that finding. Slightly retouched for clarity.)

To impeach Panduit's "taut wire" theory, Stahlin Bros. sought to admit a photograph of an electrical control panel in use in Pontiac, Michigan since 1954, which employs the one-inch Taylor duct, to prove that wires in electrical control panels are not strung tightly, but rather are strung loosely.

The District Court refused to accept the tendered exhibit, found that electrical control panels are, for the most part, tightly wired, and that the open hole of the Taylor duct traps tight wires, whereas the "substantially parallel slit" of the Walch duct does not. The District Court refused to admit the photograph upon its finding that it was "cumulative," redundant, and no more probative of Stahlin Bros.'s "slack wire" theory than other documents and testimony already in evidence. This finding, coupled with the fact

1. *See also, In re Caveney*, 155 U. S. P. Q. 681, 686 (Ct. Cl. & Pat. App. 1967).

that the exhibit had not been tendered "at least thirty days before the trial," as required by 35 U. S. C. § 282 (1964), justified, in our opinion, the District Court's exercise of discretion in refusing to admit the document.

Upon a review of all the evidence in this case, including the nearly 2,000 pages of exhibits admitted into evidence, this Court is well satisfied that the District Court had before it sufficient documentary and testimonial evidence of the nature of wiring in electrical control panels. Not only did the District Court admit several catalogues of the Panduit Corporation, Stahlin Bros., and Taylor Electric, all containing photographs of electrical control panels, but Messrs. Caveney and Luc were cross-examined extensively on the basis of several exhibits showing electrical control panels with slack wires in them.

Furthermore, the impeaching document was not tendered until the first day of trial, even though the case had been pending for about four years, a pre-trial order having been entered in March of 1965. In view of the dozens of other photographs of control panels then before the District Court, many from the Appellant's own brochures, and in view of Stahlin Bros.'s failure to show prejudice as a result of the District Court's ruling, we do not believe that the District Court abused its discretion in rejecting the tendered documents. 35 U. S. C. § 282 (1964). *See* Rule 34, Federal Rules of Civil Procedure. We also find, upon review of the record in its entirety, that the District Court was not clearly erroneous in its finding that at least some of the wires in electrical control panels are strung tightly.

Stahlin Bros. also contends that the District Court was "clearly erroneous" in refusing to admit a photograph of a "tear drop" duct allegedly manufactured by it, and a letter from Panduit's attorney to Stahlin Bros. indicating that he felt the "tear drop" duct infringed the Walch patent. The "tear drop" duct, which was not in existence at

the time suit was commenced in this case, is similar to Walch device, except the fingers have slightly convex sides. Stahlin Bros. sought to introduce these exhibits to impeach Panduit's expert testimony that convex sides, such as those in the one-inch Taylor duct, are not "substantially parallel."

Eight months before the trial of this case, the District Court held a pre-trial conference where the Appellant first mentioned this new impeaching evidence. The District Court expressly stipulated at that time, and Stahlin Bros. agreed, that this duct and the Appellee's letter could be admitted as exhibits. Stahlin Bros., however, took none of the agreed-upon steps to have it properly introduced, offering it for the first time at trial. Insofar as the "tear drop" duct was not in suit, it was not in existence at the time the suit commenced, there is a conflict as to whether it was ever even manufactured, and the Appellant has, again, failed to allege any prejudice as a result of the District Court's rejection of the tender, we do not find this ruling to have been an abuse of discretion.

For the reasons stated by the District Court, which have not been drawn seriously into question, we agree that the Taylor duct was different in kind from the Walch patent. The presumption of validity of the Walch patent, strengthened by the protracted proceedings and unusually careful scrutiny given by the patent office in this case, *see Hildreth* v. *Mastoras*, 257 U. S. 27, 32 (1921) (interference proceeding); *Modern Products Supply Company* v. *Drachenberg*, 152 F. 2d 203, 205 (6th Cir. 1945), *cert. denied* 327 U. S. 806 (1946), was not rebutted by the Taylor device.

Likewise, we agree with the District Court's finding that the Walch patent was not anticipated by the Franz patent. Unlike Taylor and Walch, Franz was not a trough, but a mere strip of material with hook-like projections emanating from its surface. The ends of the projections are flexible and may be deflected away from the backing member to

allow wires to be "clipped" between the projections and the backing. The Franz patent has the same defect as did the Taylor device: it tended to "trap" wires, or prevent their removal, if strung tightly. In addition, the Walch device has many more openings per unit length than either Taylor or Franz, because in the latter the slits, or holes, are narrower than they are high. As the District Court noted:

> "There was no testimony that Franz made Walch obvious. That is easy to understand, since even by hindsight Walch is not obvious from Franz."

Stahlin Bros.'s arguments as to infringement here are the same ones made before the District Court. We find them to be without merit substantially for the reasons stated in the opinion of the District Court, which we shall not repeat.

The judgment of the District Court is affirmed.

APPENDIX B.

No. 19786.

UNITED STATES COURT OF APPEALS

For the Sixth Circuit.

PANDUIT CORPORATION, *Plaintiff-Appellee,* v. STAHLIN BROS. FIBRE WORKS, INC., *Defendant-Appellant.*	Appeal from the United States District Court for the Western District of Michigan, Southern Division.

Decided and Filed August 7, 1970.

Appeal from the United States District Court for the Western District of Michigan.

This cause came on to be heard on the record from the United States District Court for the Western District of Michigan and was argued by Counsel.

On consideration whereof, it is now here ordered and adjudged by this Court that the judgment of the said District Court in this cause be and the same is hereby affirmed.

It is further ordered that Plaintiff-Appellee recover from Defendant-Appellant the cost on appeal as itemized below and that execution therefor issue out of said District Court.

Entered by order of the Court.

/s/ CARL W. REUSS,
Clerk.

APPENDIX C.

UNITED STATES OF AMERICA,

IN THE DISTRICT COURT OF THE UNITED STATES,

For the Western District of Michigan,

Southern Division.

PANDUIT CORPORATION,
Plaintiff,
v.
STAHLIN BROS. FIBRE WORKS, INC.,
Defendant.
} Civil Action No. 4935.

OPINION.

This is a patent infringement action brought by Panduit Corporation, a Delaware entity with its principal place of business in Illinois (hereinafter plaintiff or Panduit), against Stahlin Bros. Fibre Works, Inc., incorporated and doing business in Michigan (hereinafter defendant or Stahlin Bros.). Plaintiff, owner of Kurt R. Walch U. S. Letters Patent No. 3,024,301, by mense conveyances (hereinafter Walch patent), alleges infringement of its patent by defendant.

The Walch patent teaches a wiring grille to be utilized in the wiring of control systems for electrical equipment. Plaintiff asserts that the *defendant's "Loc" slot* duct and *"Web" slot duct* infringe the Walch patent.

The action is brought pursuant to the patent laws of the United States, 35 U. S. C. § 281, et seq. The court has jurisdiction under 28 U. S. C. § 1338.

I. Factual Background.

The control system of electrical equipment, in general, consists of a multitude of electrical components, such as relays and terminals, connected by a number of electrical wires. In order to facilitate the fabrication, subsequent revision and repair of these control systems, common practice is to install the electrical components and interconnecting wires in a metal enclosure. This entire assembly is known as an electrical control panel (shown in PX-41 and PX-66A-F). ("PX" refers to plaintiff's exhibit; "DX" refers to defendant's exhibit.)

Normally, the control panel is prefabricated as a separate unit and subsequently connected to the equipment, such as automated production line machinery, which it will control. After the control panel is joined to the machinery, the integrated unit is tested and any malfunctions corrected. If any later changes are made in the machinery or its mode of operation, changes often are also necessary in the wiring of the control panel.

Several techniques were in use before 1954 for wiring control panels, but no technique provided a satisfactory way to wire, repair and revise the control panels efficiently.

One of the earliest techniques was the "flat wiring" method in which each wire was laid flat against the back wall of the control panel. Multiple wires, running side by side in a parallel manner, were attached to the back wall. This method provided an attractive and a rather accessible panel; however, it required skilled craftsmen, was rather costly and required an inordinate amount of space.

With the development of more complex control panels, the number of electrical interconnections increased, requiring the use of more connecting wires. The space requirements for the "flat wiring" method were prohibitive and the "tied" or "laced" cable or harness method came

into common usage. In this method, the wires were installed loosely on the panel between the components. After the wires were installed, they were tied or laced together with a cord or cable. Although this method saved space, it required skilled craftsmen to make a neat installation and was very time consuming. One of the difficulties with lacing was the problem of physically tracing an installed wire. Removal and replacement of a wire were also difficult.

These two methods, flat wiring and tied or laced harness, were in common use by the late 1920's, and their shortcomings were recognized by people in the industry who were constantly searching for solutions. (Testimony of Lue, Caveney, Taylor and Walch.)

After much trial and error, General Electric produced a steel grille which had perforated round holes through which wires were threaded (PX 63A). This device was patented in the 1930's (PX 67-6A and PX 62, at 50-53). Another product in use in the early 1950's was a U-shaped wiring duct (PX 2) which incorporated multiple openings in the side walls through which wires were threaded and then connected to the electrical components.

However, ducts with holes also had shortcomings. When these ducts were filled with wires, the wires were rather inaccessible and it was difficult to trace individual wires or to revise the wiring. For example, to remove any wire from the duct, it was necessary to disconnect the wire and thread it back through the hole. If the wire was not near the top of the duct, it was frequently necessary to remove a number of wires to gain access to the wire being traced or rerouted.

Kurt R. Walch, an employee of General Electric Company since 1926, was involved with electrical control panels and thoroughly familiar with the problems involved in flat

wiring, tied or laced harness and round hole duct wiring techniques.

Mr. Walch, in 1953 as a senior advance engineer at General Electric, was given a broad assignment to improve wiring practices, including the improvement of wiring duct design. Four desirable functions or results were stressed by Mr. Walch in his work on the design of an improved wiring duct:

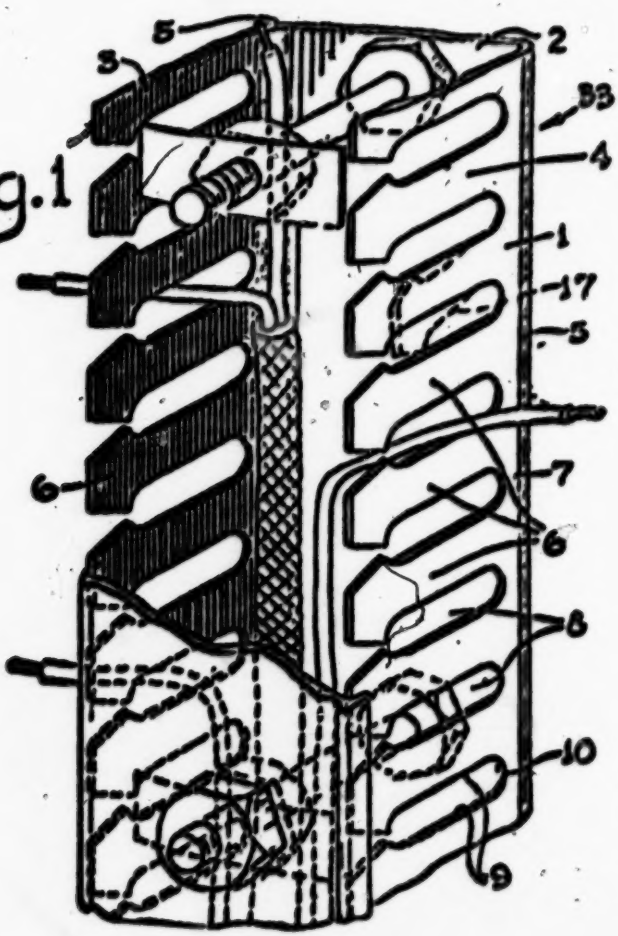
(1) Easy insertion of wires in the duct;
(2) Prevention of accidental removal of wires from the duct;
(3) Provision of maximum useful space for leading wires out of the duct; and
(4) Facilitation of intentional removal of wires from the duct.

Mr. Walch in March of 1954 proposed an open slotted grille having parallel sides of flexible fingers with a restricted throat at the top (PX 20 at pg. 20D) (hereinafter the Walch grille). In March or April of 1954, he constructed a number of test grille models (PX 63) of soft copper wire. He selected the model having parallel spaced slots, flexible fingers and restricted passages at the open ends of the slots (PX 63) as the best. A patent application was filed on the Walch grille in October 1955, which ultimately resulted in the issuance of the Walch patent in suit.

Jack E. Caveney, president of plaintiff, is an electrical engineer who has engaged in the design and use of electrical control systems for many years. His experience in this field is both theoretical and practical. He has been engaged in design, correction and revision of control panels at both the source of manufacture and at field installations. In 1955, Mr. Caveney designed a wiring duct for control panels and, on a part-time basis, started a predecessor

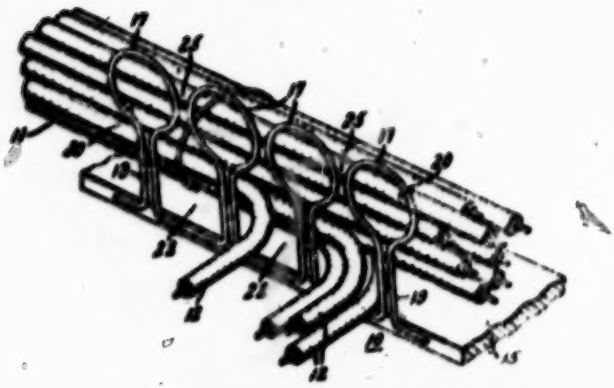
company of plaintiff to manufacture this wiring duct (hereinafter Panduit duct). This duct was similar to the Walch invention but had solid fingers instead of fingers formed of wire. In February of 1956, Mr. Caveney filed a patent application on the Panduit duct.

Fig.1



Walch

Fig. 1.



Panduit

In 1959 the Patent Office suggested to both Mr. Walch and Mr. Caveney that they copy a claim into their respective patent applications for the purpose of determining which of them was the inventor of the subject matter of the claim. Each copied the suggested claim into his patent application and the Patent Office then instituted an interference proceeding based on this claim. Mr. Walch was awarded priority of invention, and was therefore entitled to this claim in interference, and the Walch patent was issued March 6, 1962. Caveney filed a motion during the interference urging that Walch could not make the count in interference because of his wire constructions, but the Patent Office ruled that Walch could make the count. This claim in interference became claim 5 of the Walch patent in suit.

The heart of Panduit's business was the patented duct, and in order to protect its investment Panduit purchased the Walch patent from General Electric.

Mr. Caveney also continued to prosecute his application to obtain whatever additional patent protection he could on the details of the Panduit duct. This was done to determine whether he was entitled to any additional patent

protection. The court finds that he proceeded in a reasonable and prudent manner.

Mr. Caveney argued before the Patent Office examiner that although the Walch patent covered the basic invention, the solid plastic finger of the Panduit duct was a patentable improvement over the wire fingers of Walch. The examiner refused to adopt this argument and held that the Panduit duct was not patentable over the Walch patent.

Mr. Caveney appealed the examiner's decision to the Patent Office Board of Appeals and the United States Court of Customs and Patent Appeals. In 1967, the United States Court of Customs and Patent Appeals affirmed the Patent Office's rejection of the Caveney patent application, concluding that the Walch duct had all but one of the four listed advantages of the Caveney duct, that the commercial success of the Caveney duct embodied the Walch invention, and that the commercial success of the Caveney duct was attributable to those features of the Panduit duct covered by the Walch patent for which priority was awarded. In re Caveney, 155 U. S. P. Q. 687.

Plaintiff now sues defendant Stahlin Bros., claiming defendant's Loc-Slot and Web-Slot ducts infringe claim 5 of the Walch patent. Claim 5 reads as follows (PX 30) (and Fig. 2, PX 27):

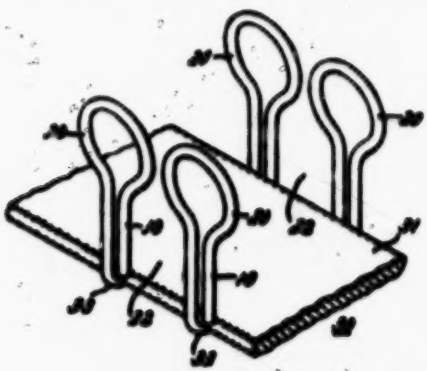


Fig. 2.

Walch device

A wall for supporting and orienting wires comprising
—a side wall (19, 20)
—having longitudinally spaced substantially parallel slits (22)
—open at one edge of said wall (25)
—and defining substantially parallel edges (19) on longitudinally spaced fingers (19, 20)
—the free ends of said fingers (20) being enlarged
—to narrow the outer ends of the slits and provide restricted passages for the wires between the finger ends and thereby prevent accidental removal of the wires from between the fingers,
—said fingers being flexible to permit their deflection and provide wider fingerspacing at their free ends to facilitate positioning and removal of wires between said fingers.

It is interesting to note that this is the claim proposed by the Patent Office in the interference proceeding between Walch and Caveney (PX 28, p. 48).

Defendant raises the defenses of invalidity and non-infringement; each is considered in separate parts of this opinion.

II. Validity.

In general, in any action in which the validity of a patent is attacked, there is a strong presumption of the validity of the patent issued by the United States Patent Office. 35 U. S. C. A. § 282; Radio Corporation of America v. Radio Engineering Laboratories, Inc., 293 U. S. 1 (1934); Ric-Wil Co. v. E. B. Kaiser Co., 179 F. 2d 401 (7th Cir. 1950), cert. den. 339 U. S. 958 (1950); Colgate-Palmolive Co. v. Carter Products, Inc., 230 F. 2d 855 (4th Cir. 1956), cert. den. 352 U. S. 843 (1956), reh. den. 352 U. S. 913 (1956); Printing Plate Supply Co. v. Crescent Engraving Co., 246 F. Supp. 654 (W. D. Mich. 1965) (hereinafter Printing Plate).

This presumption of validity is weakened if applicable prior art is not considered by the patent office. Harvey v. Levine, 322 F. 2d 481, 484 (6th Cir. 1963), Aluminum Co. of America v. Sperry Products, Inc., 285 F. 2d 911 (6th Cir. 1960), cert. den. 368 U. S. 890 (1961); France Mfg. Co. v. Jefferson Electric Co., 106 F. 2d 605 (6th Cir. 1939), cert. den. 309 U. S. 657 (1940), reh. den. 309 U. S. 696 (1940); Printing Plate, supra. See also Smith v. Hall, 301 U. S. 216 (1937); Royal Patent Corp. v. Monarch Tool & Mfg. Co., 203 F. 2d 299, 300 (6th Cir. 1953).

The defendant argues that the presumption should not operate because three prior art references, the ones relied on by defendant at trial, were not considered by the Patent Office:

(1) The prior manufacture and sale of the Taylor duct (hereinafter Taylor or Taylor duct);

(2) The prior publication of Electrical Equipment and Industrial Laboratories in May 1954; and

(3) The E. E. Franz Patent 2,712,916 (hereinafter Franz, or Franz Patent).

The application of this prior art to the Walch invention will be discussed infra. What must now be determined is whether the Patent Office considered prior art that was substantially the same as that cited by defendant. If such art was considered, the presumption of validity should stand. Solo Cup Co. v. Paper Machinery Corp., 240 F. Supp. 126, 133 (E. D. Wis. 1965); United States Gypsum Co. v. Dale Industries, Inc., 260 F. Supp. 78, 83 (E. D. Mich. 1966); Cold Metal Process Co. v. Republic Steel Corp., 233 F. 2d 828, 837 (6th Cir. 1956), cert. den. 352 U. S. 891 (1956), reh. den. 352 U. S. 955 (1956).

The Patent Office did consider prior art that was just as pertinent and very similar to that cited by defendant. Especially pertinent are V. I. Cruser, No. 2,082,099 (particularly

figures 4 and 5) (PX 67, section 7); H. F. McLoughlin, et al., No. 2,324,791 (particularly figures 11 and 12) (PX 67, section 11); and A. Robertson, No. 2,397,291 (particularly figure 2) (PX 67, section 11). This prior art includes all the important features of that cited by defendant: round holes, restricted openings, and flexibility of side walls. An examination of the prior art considered by the Patent Office persuades the court to agree with the witness, Mr. Jeffers, that the prior art considered by the Patent Office was as good as or better than that proposed by defendant. Thus the presumption of validity remains.

Furthermore, that presumption is strengthened by the careful scrutiny given by the Patent Office in this case. Modern Products Supply Co. v. Drachenberg, 152 F. 2d 203, 205 (6th Cir. 1945), cert. den. 327 U. S. 806 (1946); Printing Plate, supra. Because of the interference proceeding, the scrutiny exhibited by the Patent Office was extra careful, as noted by the seven extensive searches made in connection with the Walch and Caveney applications.

As stated by the Sixth Circuit Court of Appeals in Cold Metal Process Co. v. Republic Steel Corp., supra:

> "The best of the art relied on here was before the Patent Office and this fact strengthens the presumption of validity. Modern Products Supply Co. v. Drachenberg, 6 Cir., 152 F. 2d 203, 205, certiorari denied 327 U. S. 806, 66 S. Ct. 964, 90 L. Ed. 1030." Id. 233 F. 2d at 837.

There is a heavy burden of proof upon the party asserting invalidity. 35 U. S. C. A. § 282; Patterson-Ballagh Corp. v. Moss, 201 F. 2d 403 (9th Cir. 1953); Ezee Stone Cutter Mfg. Co. v. Southwest Indies Prod., Inc., 262 F. 2d 183 (8th Cir. 1958); Squeez-a-Purse Corp. v. Stiller, 175 F. Supp. 667 (N. D. Ohio 1959), aff'd. 280 F. 2d 424 (6th Cir. 1960), cert. den. 364 U. S. 828 (1960). Only by clear

and convincing proof can the defendant overcome the presumption of validity. Moon v. Cabot Shops, Inc., 270 F. 2d 539 (9th Cir. 1959), cert. den. 361 U. S. 965 (1960); Printing Plate, supra.

In determining validity it must be remembered that there is no natural or common law right to a monopoly of an invention. Applicants for patent monopolies under the Constitution must comply with the requirements in Title 35, United States Code, that Congress insists be met as a condition to exercising such monopoly. Holstensson v. V-M Corp., 325 F. 2d 109, 125 (6th Cir. 1963).

The standard of patentability under Title 35 has been declared by the Sixth Circuit Court of Appeals to consist of three concepts: utility, novelty and invention. Monroe Auto Equipment Co. v. Heckathorn Mfg. & Supply Co., 332 F. 2d 406 (6th Cir. 1964), cert. den. 379 U. S. 888 (1964); Harvey v. Levine, 322 F. 2d 481 (6th Cir. 1963); Maytag Co. v. Murray Corp. of America, 318 F. 2d 79 (6th Cir. 1963); Aluminum Co. of America v. Sperry Products, Inc., 285 F. 2d 911 (6th Cir. 1960), cert. den. 368 U. S. 890 (1961); Allied Wheel Products v. Rude, 206 F. 2d 752 (6th Cir. 1953); Printing Plate, supra.

The patent in suit may be said to be a combination patent, in that many of its elements have been used before, such as flexible fingers (as in Franz) and restricted openings (as in Taylor).

When all or many of the elements of a patent are old, one would expect that the standard of invention should differ from that required when new elements are disclosed. But the rule is well settled that:

> "It is established law that all the elements of a combination may be old, Diamond Rubber Company of New York v. Consolidated Rubber Tire Company, 220 U. S. 428, 442, 31 S. Ct. 444, 55 L. Ed. 527, and, if the

elements coacting produce a new and useful result, the combination is patentable. Coats Loaders & Stackers, Inc. v. Henderson, 6 Cir., 233 F. 2d 915, 921; Colgate-Palmolive Company v. Carter Products, Inc., 4 Cir., 230 F. 2d 855, 862, opinion by Chief Judge Parker." National Latex Products Co. v. Sun Rubber Co., 274 F. 2d 224, 239 (6th Cir. 1959), cert. den. 362 U. S. 989 (1960).

See also Monroe Auto Equipment Co., supra, and Firestone v. Aluminum Co. of America, 285 F. 2d 928 (6th Cir. 1960), cert. den. 368 U. S. 890 (1961).

The cases of Cold Metal Process Co. v. Republic Steel Corp., supra, and Technical Tape Corp. v. Minnesota Mining & Mfg. Co., 247 F. 2d 343 (2nd Cir. 1957), syllabae 2, 3 at page 347, cert. den. 355 U. S. 952 (1958), are startling illustrations of the fact that combinations which appear simple may, by reason of the impact which they have in their given fields, obtain patentability.

Each element of validity is hereinafter defined and applied to the patent in suit.

Utility, within the meaning of the patent statute, means that the object of the patent is capable of performing *some* beneficial function claimed for it. Smith v. Nichols, 21 Wall. (88 U. S.) 112, (1875); Seymour v. Osborne, 11 Wall. (78 U. S.) 516 (1871).

The invention need only accomplish one of the functions claimed for it to be useful. Besser v. Merrilat Culvert Core Co., 243 F. 611 (8th Cir. 1917).

A patent is prima facie evidence of utility. Crown Cork & Seal Co. v. Aluminum Stopper Co., 108 F. 856 (4th Cir. 1901).

In addition, doubts relating to utility are resolved against an infringer. Western Electric Co. v. LaRue, 139 U. S. 601 (1891); Seymour v. Ford Motor, 44 F. 2d 306, 308 (6th Cir. 1930).

With these legal considerations in mind, it is obvious that the Walch patent in suit has more than enough utility to pass muster. The elements of claim 5 are incorporated into the Panduit duct (PX 44), as are the listed objectives of the Walch invention. The testimony of Caveney and Luc indicated that the patented duct solved many problems in the control wiring field and was very useful.

Commercial success is also evidence of utility. Sandy MacGregor Co. v. Vaca Grip Co., 2 F. 2d 655, 656 (6th Cir. 1924); Seymour v. Ford Motor, supra. The commercial success of the Panduit duct, covered by the Walch patent, is undisputed. President of plaintiff, Jack Caveney, testified that in the ten years after introduction the new duct sales increased from $15,000 to $400,000. Although defendant promised to show that such success was merely due to a booming industry since other manufacturers outside the scope of the Walch patent also enjoyed great gains (defendant's Pretrial Brief, p. 26), no such evidence was produced at trial.

Considering all these facts, and the heavy burden which the law places on defendant in this instance, it is clear that claim 5 of the Walch patent possesses the requisite utility.

An application of the concepts of novelty and invention requires that they be discussed together to understand the nature of the law as it applies to the prior art and to the patent in suit.

Novelty is traditionally defined as a lack of "anticipation" by prior devices.

> "Novelty does not exist if the patented device has been anticipated by a prior device, whether patented or not. *In order to have anticipation, it is necessary that all of the elements of the patented device, or their equivalents, be found in a single prior device where the elements do substantially the same work in substantially the same way.* Firestone v. Aluminum Co. of America, 285 F. 2d 928, 930 (C. A. 6); Allied Wheel

> Products v. Rude, 206 F. 2d 752, 760 (C. A. 6); 1 Walker, Patents § 47, at 255 (Deller ed.). In other words, a device lacks novelty if there is, or has been, a substantially identical prior device." Monroe Auto Equipment Co., supra, 332 F. 2d at 414. (Emphasis supplied.)

In other words, a patented invention cannot be invalidated under Section 102 piecemeal by finding individual features separately in the prior art. Innhauser v. Burek, 101 U. S. 647, 660 (1880); Morgan Const. Co. v. Wellman-Seaver-Morgan Co., 18 F. 2d 395, 402 (6th Cir. 1927).

Prior art relied on as anticipation must in addition contain a suggestion of the way in which the result sought is accomplished by the second inventor. Munising Paper Co. v. American Sulphite Pulp Co., 228 F. 700, 703, 704 (6th Cir. 1915).

The determination of invention, or lack of it, is a vexing one, but essential to the question of validity. Judge Phillips, in the Monroe Auto Equipment case, supra, provides an excellent discussion of the difficulty in defining "that abstraction which we call invention." He goes on to consider relevant authorities and then states three considerations in reaching a decision on invention:

> "First, a determination of what the prior art was: this involves factual questions. Secondly, there is a determination of what, if any, improvement the patentee has made over the prior art; this will usually turn on expert testimony and therefore is a question of fact. The final step is to determine whether the improvement would have been obvious to one skilled in the art." Id. 332 F. 2d at 411.

See also Maytag Co. v. Murray Corp. of America, supra, 318 F. 2d at 81; Firestone v. Aluminum Co. of America, 285 F. 2d 928, 930 (6th Cir. 1960; Aluminum Co. of America v. Sperry Products, Inc., supra, 285 F. 2d at 917; Firestone v. Aluminum Co. of America, supra.

"From this it may be said that invention is synonymous with unobviousness. Thus to say that a device lacks invention and that it is obvious is to state the same legal proposition in two ways. Application of Jacoby, 309 F. 2d 513, 516, n. 3 (C. C. P. A.)." Monroe Auto Equipment, supra, 332 F. 2d at 410.

One may summarize these legal requirements to provide a step-by-step inquiry of novelty and invention:

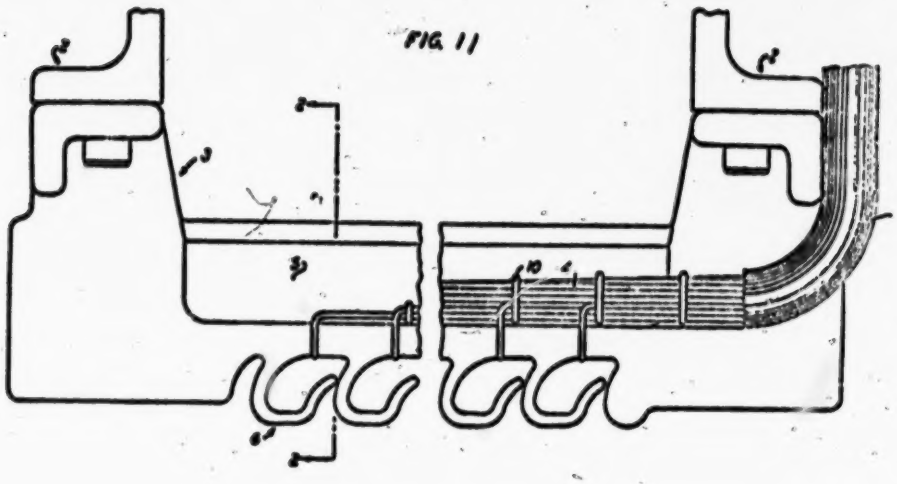
(1) Determining what the prior art was;

(2) Defining the distinctions between the prior art and the patented invention;

(a) If one piece of prior art uses all the elements of the patent claim, and in the same manner for the same results, the requirements of novelty is lacking;

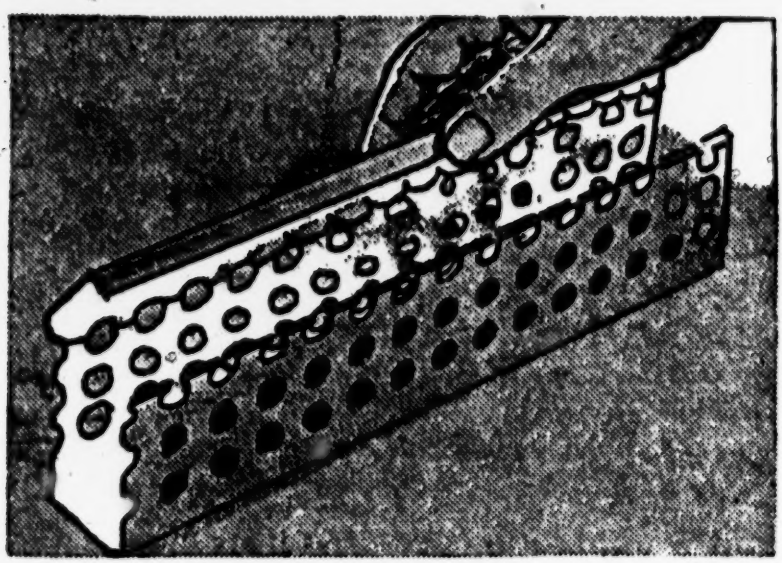
(3) Deciding whether the improvements over the prior art, if any, would have been obvious to one skilled in the art at the time of the invention.

A determination of what the prior art was is a factual inquiry. That inquiry will be limited to the prior art relied on by defendant at the trial, the Franz and Taylor devices (DX 49).



The Franz patent illustrated in Fig. 11 discloses a cable fanning strip consisting of a wall 5, having a plurality of spaced, hook-shaped projections emated therefrom 6, which terminate two-thirds of the way down in a rectangular opening closely adjacent another projection. The space 2, between end of one projection and back of the adjacent projection is smaller than the diameter of the wire placed in the opening, preventing accidental removal. The ends of the projections are flexible to provide insertion by deflecting the end and thereby widening the space between the end and the back of the adjacent projection; the remainder of the projection is to be rigid (Franz Patent, Col. 2, line 70, Col. 3, line 18).

Taylor Duct, as disclosed in May 1954 issues of Electrical Equipment (DX 9) and Industrial Laboratories (DX 10) (See also DX 11-13).



In addition to the exhibits in evidence on the Taylor duct, defendant requests the admission of newly discovered evidence: a Taylor duct installation in Pontiac, Michigan, made in 1954 and still in operation. Since the court has before

it evidence on the nature and function of the Taylor duct, on how control panels in general are wired, and believes the testimony that Taylor sold such ducts in 1954, this new evidence is merely cumulative and would add nothing to the facts already before the court. For this reason defendant's motion to admit the newly acquired evidence is denied.

The Taylor duct discloses a U-shaped wiring channel with rows of holes in the side walls. The number of rows of holes depends on the depth of the channel and/or on the order of the customer; there may be one, two or three rows. The top row of holes has a slit from the top of the hole to the top of the sidewall. At first the slit was wider than the diameter of wires to be inserted in the holes, but later the slit was narrowed, and insertion of wires could be accomplished by threading or by deflection of the sides, enlarging the opening of the slit. Once inserted, the wire could be trapped, and prevented from accidental displacement.

The holes in any rows beneath the top row are closed. The only way to place wires in those holes is to thread them.

There are substantial differences between these prior art devices and the device defined by the patent. That can first be seen by comparing the Franz and Taylor devices to the elements of claim 5.

—A side wall—both devices have a side wall

—having longitudinally spaced substantially parallel slits—(as to both Franz and Taylor, it can be said that neither has "slits," their openings being as wide as they are high. Furthermore, the adjacent edges of the openings are not substantially parallel. Neither Franz nor Taylor has this element of the claim.)

—open at one edge of said wall—this element is present in Franz and Taylor

—and defining substantially parallel edges on longitudinally spaced fingers—(neither Franz nor Taylor has substantially parallel edges, and it would be stretching the plain meaning of the words to say that the protrusions were fingers or that they were longitudinally spaced. In any event, this element of the claim is not present.)

—the free ends of said fingers being enlarged—(if the protrusions in Taylor could be called fingers, it could be said their ends are enlarged; the free ends of the Franz device are not enlarged. This element is remotely present in Taylor, but not in Franz.)

—to narrow the outer ends of the slits and provide restricted passages for the wires between the finger ends and thereby prevent accidental removal of the wires from between the fingers—(if the holes in Taylor were called slits (stretching the language), this element would be present in Taylor; however, this court expressly finds that "holes" are not "slits." The Franz device does not provide restricted passages *between* the finger ends, but between the end of one finger and the back of another. This element of the claim is thus not present in Taylor or Franz.)

—said fingers being flexible to permit their deflection and provide wider finger spacing at their free ends to facilitate positioning and removal of wires between said fingers—(broadly construed, this element can be said to be present in both Taylor and Franz.)

Thus, of the seven elements mentioned, less than half are present in either Taylor or Franz. The claim does not read on any single device in the prior art.

Neither Taylor nor Franz performs the functions or has the advantages listed by Walch and emphasized by the witnesses Caveney and Luc.

Although both prior art devices prevent accidental removal of the wires, easy insertion and removal are possible only when the wires are slack or disconnected. One of the

main objectives of the Walch patent is to allow insertion and removal of connected wires which are relatively taut. This function is especially important in tracing or in preparing for revision while the panel is "hot" (still in operation). (Testimony of Caveney and Luc.) Demonstrations at the trial showed that fingers which were substantially parallel could perform this function much better than the circular sides of Taylor and Franz.

Another important objective of the Walch patent is provision of maximum useful space for leading wires out of the duct. The Walch patent teaches many more discreet openings per unit length than Taylor or Franz, because slits are narrower than they are high, while the openings of Taylor and Franz are not. Furthermore, the design of Walch allows the wires to be placed at a substantially greater number of positions vertically through the side wall. Thus both vertically and horizontally the Walch patent provides the advantages of maximum utilization of space not present in the prior art relied on by defendant.

Taking all these facts into consideration, it is clear that neither all the elements nor all the functions of the Walch invention are present in any combination of prior art, much less in any one example of prior art. This is said keeping in mind the prior art cited by the Patent Office, as well as that relied on by defendant. The Walch patent definitely possesses the requisite novelty.

All that remains to a determination of validity is finding whether the Walch invention would have been obvious to one skilled in the art.

As to the Franz device, there is little question that it would not have made the Walch invention obvious, even in combination with other prior art known at the time. In the first place, Franz was a fanning strip rather than a wiring duct.

Second, there is no evidence that the patent was anything more than "paper" prior art that had never been used. Although all prior patents are proper references, American Air Filter Co. v. Continental Air Filters, Inc., 347 F. 2d 931 (6th Cir. 1965), the mere "paper" character of Franz lessens the weight, if any, which it should be accorded. Republic Iron & Steel Co. v. Youngstown Sheet & Tube Co., 272 F. 386 (6th Cir. 1921); Campbell v. Mueller, 159 F. 2d 803, 809 (6th Cir. 1947).

Finally, Franz simply does not suggest two of the most important teachings in Walch: maximum usable area and ability to remove and insert taut wires without disconnection.

There was no testimony that Franz made Walch obvious. That is easy to understand, since even by hindsight Walch is not obvious from Franz.

The Taylor duct provides a more difficult problem. The defendant argued that any technician who wanted to expand usable area would have merely extended the holes of the Taylor duct downward, thus forming a duct identical to the Panduit duct which plaintiff agrees is covered by the Walch patent. The testimony of Taylor and Pollock, who designed the Taylor duct, supported this conclusion.

The actions of these two witnesses at the critical time belie their conclusions of obviousness stated in court, with Panduit and Walch before them. What seems obvious to them now was clearly not obvious to them at the time. When they wanted a greater area vertically, they punched closed holes in rows below the top holes (DX 9-10). Pollock testified that he tried the slit idea; but he rejected it out of hand, neither recognizing any of its great advantages nor noting its solution to the nagging problems in the electrical control panel field.

The advantages of the Walch invention were so unobvious to the people at Taylor that in time they reverted to

the completely closed hole construction (PX 59, pp. 15-18, 20-23). Only when their customers demanded a duct similar to the Panduit duct did they return to a duct with any openings to the top of the side wall. (Testimony of Taylor.) In short, the Walch invention was so unobvious that even when the Taylor people were on the brink of discovering it they had no idea of what they were on the brink of or what its advantages might be.

Defendant put great weight on its Exhibit 465—Exhibit C—showing a one-inch Taylor duct superimposed on a one-inch Panduit duct. Only one opening is shown on the exhibit, however, making it difficult to determine which duct provides easier access and removal through more flexible protrusions, and which provides more discreet openings per unit length. By viewing the die which made the Taylor duct (DX 22), it can be seen that the Taylor holes are spaced much wider apart than the slits in Panduit. Furthermore, the openings in the Taylor duct are round, rather than straight. This feature means the access and removal in Taylor is more difficult, tending to trap the wires when the fingers are deflected.

This is not a difference in degree, but a difference in kind. The fact is that the Taylor people, and most others in the field, were "hung up" on round holes, failing to see the advantages of slits with substantially parallel sides.

This improvement, which seems simple and obvious by hindsight, was not obvious at the point in time just prior to when the patented device was made. As the court said in Monroe Auto Equipment, supra, 332 F. 2d at 412:

> "* * * in considering the question of obviousness, we must view the prior art from the point in time just prior to when the patented device was made. *Many things may seem obvious after they have been made, and for this reason courts should guard against slipping into use of hindsight. We must be careful to*

> *'view the prior art without reading into that art the teachings of appellant's invention.'* Application of Sporck, 301 F. 2d 686, 689 [49 CCPA 1039]." (Emphasis supplied.)

Thus, the court concludes that the Walch device has novelty, utility, and invention. The presumption of validity remains and Walch Patent 3,034,301 is valid.[1]

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1. Defendant has proposed introduction of a Stahlin duet called the "teardrop," and also of a letter from plaintiff's attorney stating that he considers that the teardrop would be an infringement. Defendant's avowed purpose in bringing in this duet, which was not in existence at the time this suit was instituted and is not in issue, is to show that since plaintiff thinks claim 5 covers the slightly curved sides of the "teardrop," he cannot distinguish the prior art on the basis that it has curved sides. None of the cases cited by defendant apply, because in all those cases an action had been instituted on the item analogous to the "teardrop."

Such is not the case here. In fact, there is a dispute as to whether the "teardrop" is even manufactured. Plaintiff has not charged an infringement by the teardrop; his only opinion was in response to an inquiry by defendant's attorney.

There are means by which the defendant could have brought this evidence in. The procedure was discussed at the pre-trial and the defendant agreed to proceed with the preferred manner of bringing the teardrop into the case:

> "Mr. Petherbridge (plaintiff's attorney): The Federal Rules provide exactly for this alternative. If you wish to raise something, raise it by counterclaim. We have alleged and set up a complete cause of action based on what we know.
>
> The Court: Can you cover it in a responsive pleading?
>
> Mr. Simpson (defendant's attorney): We are not arguing, Your Honor, about the technicalities of how it should be raised. *We are willing to do whatever needs to be done to bring this in,* but we want to have it tried during the course of this trial if the plaintiff is going to continue to contend that it does in fact infringe.
>
> The Court: Why don't you bring it in?
>
> Mr. Simpson: By counterclaim, amendment to the Answer—
>
> The Court: On the proposition—counterclaim or whatever kind of pleadings are necessary. * * *" (Pretrial Tr. p. 21.) (Emphasis supplied.)

Considering defendant's agreement to bring the "teardrop" in in the proper way, his lack of case authority for it otherwise being admissible, and the general proposition that devices manufactured by defendant after the institution of the suit are not admissible, the "teardrop" evidence will not be admitted.

III. Infringement.

The burden of proving patent infringement in this case is on the plaintiff, which is charging infringement. United States Rubber Co. v. General Tire & Rubber Co., 128 F. 2d 104, 108 (6th Cir. 1942); Aluminum Co. of America v. Thompson Products, Inc., 122 F. 2d 796 (6th Cir. 1941).

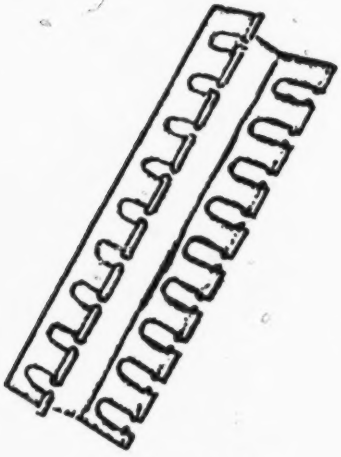
The patent claim measures the grant, McLain v. Ortmayer, 141 U. S. 419 (1891)[2] and is the beginning point of

2. See also cases cited in an excellent article by Thomas Koykka, Infringement of Patents, 42 F. R. D. 43, 45-46 (1967).

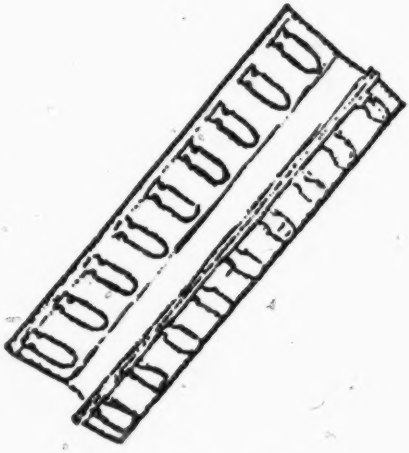
infringement. As the United States Supreme Court declared in the case of Graver Tank and Mfg. Co. v. Linde Air Products Co., 339 U. S. 605, 607 (1950):

> "In determining whether an accused device or composition infringes a valid patent, resort must be had in the first instance to the words of the claim. If accused matter falls clearly within the claim, infringement is made out and that is the end of it."

There is no dispute in this case that the words of the claim read literally on defendant's Loc-Slot duct. (See PX 30 and PX 30a.)



Loc-Slot



Web-Slot

But even when the words of the claim read precisely on defendant's product, that is not quite "the end of it." Infringement is not a mere matter of words. General Electric Co. v. Allis-Chalmers Co., 178 F. 273, 276 (1910); Westinghouse v. Boyden Power Brake Co., 170 U. S. 537 (1898); Linde Air Products Co. v. Morse Dry Dock & Repair Co., 246 F. 834, 838 (2nd Cir. 1917).

"The question of infringement involves considerations of practical utility and substantial identity, and therefore must be quantatative as well as qualitative." Goodyear Shoe Mach. Co. v. Spaulding, 101 F. 990, 994 (1st Cir. 1900).

The defendant contends that both the Loc-Slot and Web-Slot ducts have solid fingers, while the Walch patent illustrates hollow fingers formed of wire.

A patent is not limited, however, to the particular embodiment of the invention shown and described in the specification, since the claims of the patent measure the invention. Holstensson v. Webcor, Inc., 150 F. Supp. 441 (N. D. Ill. 1957).

The doctrine of equivalents has been used to extend the protection of the patent to an equivalent which "performs substantially the same function in substantially the same way to obtain the same result." Graver Tank & Mfg. Co. v. Linde Air Products Co., supra.

This language applies exactly to defendant's Loc-Slot and Web-Slot ducts. Both perform the same function disclosed by Walch: a wiring duct with a maximum number of discreet openings for use in control panels.

Both operate in substantially the same way as the Walch device, and obtain the same result. Wires are inserted and removed by deflecting the fingers, they are held in place by the resiliency of the fingers, and a maximum amount of

vertical and horizontal space is provided for the exit of the wires.

Defendant argues that the Web-Slot duct is substantially different because none of the slits have openings to the top of the side wall. However, in the past defendant has instructed its customers to snip the web to insert wires (PX 11B). Once snipped, the Web-Slot operates in the same way as the Loc-Slot and the Walch patented device.

Defendant further claims that it has not been shown that any Web-Slot duct has ever been snipped. But a photograph of a web which has been snipped appears on the back page of the defendant's own literature. (PX 11B.)

Thus, defendant's argument as to the Web-Slot duct is not meritorious. The plain facts are that the Web-Slot operates almost identically to the Loc-Slot, and both are equivalent to the Walch patent.

Finally, defendant argues that Walch never invented or seriously contemplated solid fingers, and his invention should not be extended that far. The facts do not support this view. The testimony of Walch, corroborated by his notes (PX 20) and the deposition testimony of General Electric patent attorney Freeman (PX 24, pp. 33-36), establish that Walch considered his invention to cover types of wiring grilles other than the wire form grille.

The Patent Office also considered this to be true, since claim 5, the count suggested by the Patent Office in the interference proceeding, is silent as to material of construction. The difference between solid fingers and those formed of wire was also minimized by the decision of the Court of Customs and Patent Appeals supra.

All these considerations, together with the fact that fingers formed of wire operate substantially the same way and achieve the same results, persuade the court that the Walch patent in suit applies to solid fingers.

In summary, the claim reads literally on the Loc-Slot and on the Web-Slot, when snipped. Both these ducts are also "equivalents" of the Walch invention. The plaintiff has met its burden of establishing that both the Loc-Slot and Web-Slot ducts manufactured by defendant directly infringe claim 5 of its valid patent No. 3,024,301.

An order may be entered granting plaintiff the injunctive relief prayed for, as well as an accounting.

Decision of the question of treble damages, costs, and attorney fees is withheld pending the accounting.

This opinion constitutes the Findings of Fact and Conclusions of Law pursuant to Rule 52(a) of the Federal Rules of Civil Procedure.

Dated: April 11, 1969.

NOEL P. FOX,
District Judge.

APPENDIX D.

IN THE DISTRICT COURT OF THE UNITED STATES,
For the Western District of Michigan
Southern District.

PANDUIT CORPORATION,
Plaintiff,
vs.
STAHLIN BROS. FIBRE WORKS, INC.,
Defendant.
} Civil Action No. 4935.

JUDGMENT.

This action came on for trial before the Court, Honorable Noel P. Fox, District Judge, presiding, and the issues having been duly tried and a decision having been duly rendered on April 11, 1969,

IT IS ORDERED AND ADJUDGED:

That claim 5 of United States Letters Patent No. 3,024,301 is valid and infringed by Defendant and Judgment is hereby rendered for Plaintiff.

Dated at Grand Rapids, Michigan this 29 day of April, 1969.

So Ordered:

Noel P. Fox,
Judge, United States District Court
Western District of Michigan,
Southern Division.

APPENDIX E.

UNITED STATES COURT OF APPEALS

For the Sixth Circuit

PANDUIT CORPORATION, *Plaintiff-Appellee,* *vs.* STAHLIN BROS. FIBRE WORKS, INC., *Defendant-Appellant.*	No. 19,786.

ORDER.

Before: WEICK, EDWARDS and CELEBREZZE, *Circuit Judges.*

Upon due consideration, Defendant-Appellant's petition for rehearing is hereby denied.

ENTERED BY ORDER OF THE COURT
/s/ CARL W. REUSS,
Clerk.

Document stamped "Filed Sep 8 1970 Carl W. Reuss, Clerk".

APPENDIX F.

Amendment V to the Constitution of the United States provides:

> No person shall be held to answer for a capital, or otherwise infamous crime, unless on a presentment or indictment of a Grand Jury, except in cases arising in the land or naval forces, or in the Militia, when in actual service in time of War or public danger; nor shall any person be subject for the same offence to be twice put in jeopardy of life or limb; nor shall be compelled in any criminal case to be a witness against himself, nor be deprived of life, liberty, or property, without due process of law; nor shall private property be taken for public use, without just compensation.

United States Code, Title 35, Section 102 provides in part:

> A person shall be entitled to a patent unless—
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or
>
> • • • • •
>
> (g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

United States Code, Title 35, Section 103 provides:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

United States Code, Title 35, Section 271 provides in part:

> (a) Except as otherwise provided in this title, whoever without authority makes, uses or sells any patented invention, within the United States during the term of the patent therefor, infringes the patent.
>
> (b) Whoever actively induces infringement of a patent shall be liable as a direct infringer.
>
> (c) Whoever sells a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.

The Pretrial Order of the District Court of the Western District of Michigan provided in part:

> 2. Exhibits. Exhibit to opposing counsel, or, if more convenient, supply him with copies of all documents and exhibits embraced within Rule 34 of the Federal Rules of Civil Procedure, other than those to be used for impeachment, which are intended to be offered at the trial by each party represented. Within ten days thereafter, the party who has had tendered to him the inspection of such documents shall reply in writing, stating the grounds, if any, upon which he will challenge the admissibility of any such documents.

SUPREME COURT, U. S.

FILED

JAN 27 1971

E. ROBERT SEAVER, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1970.

No. 1004

STAHLIN BROS. FIBRE WORKS, INC.,
Petitioner,

vs.

PANDUIT CORPORATION,
Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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IN THE

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OCTOBER TERM, 1970.

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STAHLIN BROS. FIBRE WORKS, INC.,
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vs.

PANDUIT CORPORATION,
Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

STATEMENT.

Panduit Corporation, Respondent and herein called Plaintiff, opposes grant of the Petition for Writ of Certiorari filed in the captioned cause by Petitioner, Stahlin Bros. Fibre Works, Inc., herein called Defendant.

Defendant has correctly referred to the Opinions below and its statement of jurisdiction is not in question. However, the statements in the first and last sentences of the paragraph bridging pages 1 and 2 of the Petition are questioned. Defendant actually appealed to the Court of Appeals for the Sixth Circuit, not only from the judgment of the District Court sustaining validity of the patent in suit, but *also from the judgment finding infringement*, as

evidenced by the fourth question posed by the instant Petition.

Plaintiff also submits that the Defendant's statement of the issues of the case omits significant matters, are misleading, and, in certain respects, the facts as stated are slanted, if indeed not misstated.

Restated, the questions posed by the Defendant are:

I. Did the District Court and the Court of Appeals for the Sixth Circuit properly apply the correct standard of patentability required by 35 U. S. C. 103, in accordance with the interpretation thereof by this Court?

II. Did the District Court and the Court of Appeals for the Sixth Circuit base their decisions of unobviousness *solely* on an "afterthought" function of the invention?

III. Was Defendant prejudiced and denied due process by the refusal of the District Court to allow Defendant to introduce a catalog at the Trial for the alleged purpose of impeaching the testimony of a witness of Plaintiff and was this refusal based *solely* on the ground that the catalog had not been marked as an exhibit at Pre-Trial in accordance with the Pre-Trial Order?

IV. Was the evidence before the District Court sufficient to support the Court's finding of fact that Plaintiff sustained its burden of proving that one of the Defendant's products infringed Claim 5 of the patent in suit?

The first two of these questions relate to the propriety of the application of the statutory standard of invention by the District Court and the Court of Appeals, and the last two questions relate to evidentiary matters.

SUMMARY OF ARGUMENT.

Introduction:

The case involves infringement of Claim 5, which was drafted by the Patent Office Examiner. The statement of facts is contained in District Court (DC in Summary of Argument) and Appellate Court decisions. The invention involved was subjected to seven searches in the Patent Office, searches by the Defendant, and was considered by Patent Office Board of Appeals, Court of Custom and Patent Appeals, DC and Court of Appeals, and the finding of invention has been unanimous. The lower Courts considered and followed the mandates of this Court and applied proper standards to the voluminous evidence.

Summary as to Issues:

Defendant has misconstrued the issues, used misleading drawings and predicates its issues on premises contrary to the evidence. The two evidentiary issues are contrary to fact and no prejudicial error was committed.

Question I:

Validity of Claim 5 over Taylor was contested before the lower Courts, which followed the mandates of the *John Deere* case and properly applied the required standard of invention. The sketches in the petition are misleading, are not in evidence and the actual structures are shown in the brief fold-out.

Defendant ignores the differences in function and results and says only structural differences are to be considered, contrary to all precedent.

Only 35 USC 103, and not 102, is involved.

Differences in structure, function and results must all

be considered under the *Deere* case. The DC treated the required tests of invention by:

(a) determining what was the prior art;
(b) defining the distinctions between the prior art and the invention; and
(c) deciding whether the improvements would have been obvious.

The DC considered these requirements in light of the factual background, which was set forth in its decision, and then followed the proper tests in considering Taylor.

The substantial treatment of Taylor by DC is set forth verbatim wherein: Taylor is analyzed, compared to Claim 5 and found to have less than half the structural elements of the Claim; the functions and results of Taylor are analyzed and compared to those of the invention and Taylor is found lacking in two of four essential requirements; obviousness of the invention is treated as to Taylor and the invention is found unobvious even to the experts at Taylor, who did not recognize the advantages when on the brink of discovering the invention and who reverted back to old structures and away from the invention and; the invention is found to be a difference in kind and not degree and the patent was found valid.

Structure:

The Courts below obviously followed proper standards and Defendant only mis-states the issues, since Taylor is missing five elements of Claim 5 as testified by Defendant's own witnesses.

Functions and Results:

Taylor is missing two of four requirements i.e., ease of wire insertion and removal and maximum useful area to bring wires out of the duct. The lower Courts were war-

ranted in finding invention under the primary factors of the *Deere* standard, considering structure, function and results. *Deere* allows the Courts to consider secondary factors such as commercial success, long-felt need, failure of others to solve problems and immediate acceptance of the invention, and the evidence established all of these.

The Courts below found invention on the primary tests and found it unnecessary to use secondary factors, although established. The Defendant bases the question on premises contrary to evidence as shown by record references and findings of fact below. The Courts below correctly followed this Court's mandates and there is no basis for grant of certiorari.

Question II:

This question again is based on the same false premises. Contrary to Defendant's position, the testimony established that three prior patents were considered by the Patent Office disclosing restricted wire receiving openings, before the Examiner drew the claim. Contrary to the findings of fact, that less than half the claim elements were present in Taylor, the Defendant says the issue is flat rather than rounded sides, and claims that flat sides rather than rounded sides was an "afterthought". However, the elements of the invention are set forth in the claim and Taylor lacks five elements of the structure and two of four essential features.

The inventor testified that he contemplated the full invention of structure, functions and results of the claim and they were inherently included therein, so the "afterthought" argument is contrary to fact.

Question III:

The question is based on the same false premises and Defendant asserts denial of due process by DC's exclusion of one catalog from evidence on the *sole* ground of failure to mark it at the pre-trial, which is all contrary to fact. The Court's pre-trial order is reproduced and the record referred to to show the Court's refusal was based on Defendant's failure to show *good cause*. DC found the catalog merely *cumulative of other evidence*, treated the matter throughout the trial, kept it under advisement, had the issues fully briefed and only ruled after trial. The "other" evidence is discussed, and the Appeals Court was "well satisfied" that the DC had sufficient other evidence before it.

No substantive or procedural due process was denied, no error committed or no good cause or prejudice was shown.

Question IV:

Defendant misstates the issue since the DC actually held that Plaintiff had met the burden of establishing *direct* infringement. The real question is whether there was sufficient evidence of direct infringement. Plaintiff has the burden to prove infringement and when its prima facie case is established the burden shifts to the Defendant. The Defendant offered *no evidence* in rebuttal. DC indicated at the close of Plaintiff's case that infringement existed and the burden had shifted. The DC ruling is set forth verbatim, and yet Defendant offered no rebuttal evidence.

The evidence of infringement is delineated and the Defendant's president's testimony is quoted, including the examination by the Court, to clearly establish infringe-

ment. The issue was treated in detail at the trial, in closing arguments and in the briefs, and DC's finding of fact was specific.

The Court of Appeals was sufficiently convinced of the correctness that they affirmed on this issue for same reasons as DC. Since DC found direct infringement, Defendant's argument regarding contributory and inducement and the *Aro* case are inapropos.

Conclusion:

No question is presented warranting the grant of the petition. Primarily only issues of fact are involved, and no special and important reasons appear, so the petition should be denied.

ARGUMENT.

INTRODUCTION.

This is a patent infringement action involving Claim 5 of the patent in suit. Claim 5 is set forth on the fold-out at the back hereof and was drafted by the Patent Office Examiner for purposes of provoking an interference between the Walch application maturing into the patent in suit and an application of Mr. Caveney, President of Plaintiff.

A statement of the facts of the case are contained in the District Court Decision (Pet. for Cert., Appx. C) and the Court of Appeals Decision. (Pet. for Cert., Appx. A.)

From the standpoint of patentability, this claim was subjected to at least seven different prior art searches in the Patent Office, was considered by the Board of Appeals of the United States Patent Office, was considered by the United States Court of Custom and Patent Appeals, was extensively searched by the Defendant, and was subject to the scrutiny of the District Court and the Court of Appeals in this cause. Consistently this claim survived the test of the standard of patentability set out in the Patent Statute, 35 U. S. C. 102 and 103, as interpreted by this Court. As a matter of fact, the Defendant originally asserted that approximately 92 patents would be used at the District Court level to invalidate Claim 5, but relied on only two references at the trial and is now before this Court with only one of these two references as invalidating this Claim. Throughout the proceedings before the District Court and the Court of Appeals, both the parties and the Courts treated and considered the mandates of this Court and specifically considered and applied the standard of inven-

tion set forth in *Graham* v. *John Deere*, 383 U. S. 1, the case upon which Petitioner relies. Moreover, the Courts below had before them for consideration in reaching their decisions over 1,000 pages of testimony, which took approximately two weeks to present and included the testimony of seven different expert witnesses, and over 2,000 pages of exhibits.

This invention has been prodigiously subjected to the proper standard of invention as pronounced by this Court.

AS TO THE ISSUES.

The issues stated by the Defendant are contrary to the evidence in the case. The invention does not involve "flattened sides" vs. "rounded sides" (terms never before used or heard in the case) but involves a new and novel structural arrangement that functions in a different manner than the prior art and produces new and different results. It is important to note and bear in mind that Figure 1 and Figure 2 of the Petition are misleading, have never heretofore been used in the case, were not in evidence before the lower Courts, are not now in evidence and do not represent the prior art or the patented device. Furthermore, the Patent Office did not "predicate patentability on the recitation of a restricted passage into the holes and not on the shape of the edges of the holes . . ." as the Defendant states. The evidence, and in fact the patentee's own testimony establishes that there is no "afterthought function" as Defendant now contends.

The two evidentiary issues raised by Defendant are without support in fact or law. First, no error at all was committed by the District Court's refusal to receive a document into evidence. The refusal *was not based solely* on Defendant's failure to mark the document at the Pre-Trial conference, but upon Defendant's failure to show "good

cause" for its admission, and certainly Defendant was in no way *prejudiced* because, as found by both Courts below, the document was "cumulative, redundant, and no more probative . . . than other documents and testimony in evidence". Contrary to Defendant's statement that there was "no evidence of direct infringement" the record contains substantial documentary and testimony evidence on this matter.

Accordingly, there are no questions presented in this Petition to warrant granting of Certiorari.

QUESTION NO. I

Validity of Claim 5 of the patent in suit in view of the teachings of the Taylor reference (here forming the basis of Question No. I of the present Petition) was sharply at issue during the trial and in the Post-Trial Briefs and separately considered in the District Court decision. The District Court was fully apprised of the requirements of the standard of patentability as it related to Taylor by citing the Sixth Circuit case of *Monroe Auto Equipment Co.* v. *Heckathorn Mfg. & Supply Co.*, 332 F. 2d 406 (6 Cir., 1964), cert. den., 379 U. S. 888 (1964) which specifically recognized and followed the mandates of the *Graham* v. *John Deere* case relied on by Defendant in its Post-Trial brief, Appeal briefs and in the instant Petition. Thus, being fully aware of the standard of patentability to be applied, it is quite clear the District Court, indeed, did apply this standard in finding that the Walch invention met this standard.

The Court of Appeals for the Sixth Circuit fully considered the decision of the District Court and its findings on the issue of validity in view of not only Taylor but the other prior art patent relied on by Defendant, sustained these findings, and amplified upon them in its Opinion.

As aforesaid, for the purposes of the present Petition, Defendant relies only on the alleged Taylor structure. Using *two perspective sketches, which neither Respondent nor the Courts below had ever seen before and which were not in evidence at the trial* (pp. 3 and 4 of the Petition), of the *alleged* Taylor structure and the *alleged* patented structure, Defendant's position, in a nutshell, is that, applying the statutory standard of invention of 35 U. S. C. 103, as interpreted by this Court, invention does not exist in flattening out the sides of a round hole. The reader is requested to compare Figure 1 of the Petition with the Taylor prior art in the fold-out at the back hereof to clearly understand that Figure 1 is not the prior art and compare Figure 2 with the commercial Panduit duct or Defendant's infringing Lok-Slot duct to understand the patented device.

Defendant's apparent interpretation of the statutory standard of invention is that only *structural* differences are to be considered and that *differences in functions and results* produced by structural differences have no bearing at all on the question of invention under the statutory standard of invention.

Certainly, structural considerations only without regard to functions and results have never been the standard of invention established by the patent statute under 35 U. S. C. 103 or by the case law interpretation of that standard by this Court (Respondent notes parenthetically that Section 102 of the United States Code, Title 35, is inapropos, contrary to Defendant's statement on Page 5 of its Petition, because this section of the patent statute requires that, to invalidate, the prior art structure must have the same structure as the invention. By its own admission on Page 7 of its Petition, the *structure* of the Taylor prior art reference is *different* from the structure of the Walch patent. Thus, Section 103 of the Patent Act, 35 U. S. C., is the only

section of the patent statute actually being asserted by Defendant in its Petition).

When only structural differences are involved in an invention, "a mere change of form", then Thomas Jefferson's comments, quoted in the *Graham* v. *John Deere* case of this Court on Page 7 of the Petition are apropos. But structural difference is not the only element of the test of invention and one must consider functions and results. When Columbus proved that the world was round, it was not only the structure of the world which was considered important, but what this enabled mankind to do (functions) and what results emanated from this discovery. Also, there may be no unobvious differences *structurally* between a round bucket and a square bucket. However in application to certain arts, there may be unobvious differences in functions and results produced. The same rationale can be applied to a square wheel and round wheel. Thus, the sophistry of Defendant's rationale in connection with this question is readily apparent.

The District Court in this case recognized and fully treated the legal requirements or tests of the statutory standard of invention, as interpreted by this Court. The District Court in its decision stated these requirements to be:

(1) Determining what the prior art was;

(2) Defining the distinctions between the prior art and the patented invention;

(a) If one piece of prior art uses all the elements of the patent claim, and in the same manner for the same results, the requirements of novelty is lacking;

(3) Deciding whether the improvements over the prior art, if any, would have been obvious to one skilled in the art at the time of the invention.

For comparison purposes, embodiments of the Walch invention are shown on the fold-out at the back of this Brief, as exemplified by the Plaintiff's Commercial Panduit Duct and by the Defendant's Infringing Lok-Slot Duct. It is also again noted that the Taylor duct in evidence is not that shown in the schematic sketch in the Petition, but is shown in the back fold-out.

The application of these requirements of the statutory standard were considered by the District Court in the light of the factual background adduced by the evidence at the trial. To synopsize the District Court's findings with regard to this factual background would not do justice to the depth of application of the statutory standard by the District Court in its decision. Therefore, the reader is requested to read this factual background, verbatim, commencing on page A12 through page A18 (middle of the page) of Appendix C of the Petition.

Against this factual background and following the mandates of this Court, the District Court then determined from the evidence what the prior art was, defined the distinctions in terms of structure, functions and results, between the prior art and the patented invention and, from these factual inquiries, decided that the improvements of the Walch invention over this prior art including the Taylor device would not have been obvious to one skilled in the art at the time of the invention.

Regarding the Taylor prior art, the District Court treated this prior art in the framework of its application of the correct standard of invention:

> "The Taylor duct discloses a U-shaped wiring channel with rows of holes in the side walls. The number of rows of holes depends on the depth of the channel and/or on the order of the customer; there may be one, two or three rows. The top row of holes has a slit from the top of the hole to the top of the sidewall.

At first the slit was wider than the diameter of wires to be inserted in the holes, but later the slit was narrowed, and insertion of wires could be accomplished by threading or by deflection of the sides, enlarging the opening of the slit. Once inserted, the wire could be trapped, and prevented from accidental displacement.

The holes in any rows beneath the top row are closed. The only way to place wires in those holes is to thread them.

There are substantial differences between these prior art devices and the device defined by the patent. That can first be seen by comparing the Franz and Taylor devices to the elements of claim 5.

—A side wall—both devices have a side wall

—having longitudinally spaced substantially parallel slits—(as to both Franz and Taylor, it can be said that neither has 'slits,' their openings being as wide as they are high. Furthermore, the adjacent edges of the openings are not substantially parallel. Neither Franz nor Taylor has this element of the claim.)

—open at one edge of said wall—this element is present in Franz and Taylor

—and defining substantially parallel edges on longitudinally spaced fingers—(neither Franz nor Taylor has substantially parallel edges, and it would be stretching the plain meaning of the words to say that the protrusions were fingers or that they were longitudinally spaced. In any event, this element of the claim is not present.)

—the free ends of said fingers being enlarged—(if the protrusions in Taylor could be called fingers, it could be said their ends are enlarged; the free ends of the Franz device are not enlarged. This element is remotely present in Taylor, but not in Franz.)

—to narrow the outer ends of the slits and provide restricted passages for the wires between

the finger ends and thereby prevent accidental removal of the wires from between the fingers—(if the holes in Taylor were called slits (stretching the language), this element would be present in Taylor; however, this court expressly finds that 'holes' are not 'slits.' The Franz device does not provide restricted passages *between* the finger ends, but between the end of one finger and the back of another. This element of the claim is thus not present in Taylor or Franz.)

—said fingers being flexible to permit their deflection and provide wider finger spacing at their free ends to facilitate positioning and removal of wires between said fingers—(broadly construed, this element can be said to be present in both Taylor and Franz.)

Thus, of the seven elements mentioned, less than half are present in either Taylor or Franz. The claim does not read on any single device in the prior art.

Neither Taylor nor Franz performs the functions or has the advantages listed by Walch and emphasized by the witnesses Caveney and Luc.

Although both prior art devices prevent accidental removal of the wires, easy insertion and removal are possible only when the wires are slack or disconnected. One of the main objectives of the Walch patent is to allow insertion and removal of connected wires which are relatively taut. This function is especially important in tracing or in preparing for revision while the panel is 'hot' (still in operation). (Testimony of Caveney and Luc.) Demonstrations at the trial showed that fingers which were substantially parallel could perform this function much better than the circular sides of Taylor and Franz.

Another important objective of the Walch patent is provision of maximum useful space for leading wires out of the duct. The Walch patent teaches many more discreet openings per unit length than Taylor or

Franz, because slits are narrower than they are high, while the openings of Taylor and Franz are not. Furthermore, the design of Walch allows the wires to be placed at a substantially greater number of positions vertically through the side wall. Thus both vertically and horizontally the Walch patent provides the advantages of maximum utilization of space not present in the prior art relied on by defendant.

Taking all these facts into consideration, it is clear that neither all the elements nor all the functions of the Walch invention are present in any combination of prior art, much less in any one example of prior art. This is said keeping in mind the prior art cited by the Patent Office, as well as that relied on by defendant. The Walch patent definitely possesses the requisite novelty.

All that remains to a determination of validity is finding whether the Walch invention would have been obvious to one skilled in the art. * * *

The Taylor duct provides a more difficult problem. The defendant argued that any technician who wanted to expand usable area would have merely extended the holes of the Taylor duct downward, thus forming a duct identical to the Panduit duct which plaintiff agrees is covered by the Walch patent. The testimony of Taylor and Pollock, who designed the Taylor duct, supported this conclusion.

The actions of these two witnesses at the critical time belie their conclusions of obviousness stated in court, with Panduit and Walch before them. What seems obvious to them now was clearly not obvious to them at the time. When they wanted a greater area vertically, they punched closed holes in rows below the top holes (DX 9-10). Pollock testified that he tried the slit idea; but he rejected it out of hand, neither recognizing any of its great advantages nor noting its solution to the nagging problems in the electrical control panel field.

The advantages of the Walch invention were so unobvious to the people at Taylor that in time they

reverted to the completely closed hole construction (PX 59, pp. 15-18, 20-23). Only when their customers demanded a duct similar to the Panduit duct did they return to a duct with any openings to the top of the side wall. (Testimony of Taylor.) In short, the Walch invention was so unobvious that even when the Taylor people were on the brink of discovering it they had no idea of what they were on the brink of or what its advantages might be.

Defendant put great weight on Exhibit 45—Exhibit C—showing a one-inch Taylor duct superimposed on a one-inch Panduit duct. Only one opening is shown on the exhibit, however, making it difficult to determine which duct provides easier access and removal through more flexible protrusions, and which provides more discreet openings per unit length. By viewing the die which made the Taylor duct (DX 22), it can be seen that the Taylor holes are spaced much wider apart than the slits in Panduit. Furthermore, the openings in the Taylor duct are round, rather than straight. This feature means the access and removal in Taylor is more difficult, tending to trap the wires when the fingers are deflected.

This is not a difference in degree, but a difference in kind. The fact is that the Taylor people, and most others in the field, were 'hung up' on round holes, failing to see the advantages of slits with substantially parallel sides.

This improvement, which seems simple and obvious by hindsight, was not obvious at the point in time just prior to when the patented device was made. As the court said in Monroe Auto Equipment, supra, 332 F. 2d at 412:

> '. . . in considering the question of obviousness, we must view the prior art from the point in time just prior to when the patented device was made. *Many things may seem obvious after they have been made, and for this reason courts should guard against slipping into use of hindsight. We must be careful to view the prior art without reading*

> *into that art the teachings of appellant's invention.'* Application of Sporck, 301 F. 2d 686, 689 [49 CCPA 1039].' (Emphasis supplied.)
>
> Thus, the court concludes that the Walch device has novelty, utility, and invention. The presumption of validity remains and Walch Patent 3,034,301 is valid."

It is quite evident that the District Court recognized and correctly applied the standard of invention as set out in the Patent Statute and as interpreted by this Court.

The Court of Appeals also recognized the issue of the proper application of the statutory standard of invention and carefully reviewed the evidence relied upon by the District Court in its application of the standard. The Court of Appeals affirmed the District Court in all respects regarding the issue of validity.

Certainly, the issue before the District Court and the Court of Appeals was not that of "rounded sides" as opposed to "flattened sides", both with restricted passages, as Defendant now contends.

Structure.

The evidence at the trial established clearly and convincingly, as the Court below found, that the slotted round hole Taylor duct did not have the following structural elements of claim 5:

A. Longitudinally spaced slits;
B. Parallel slits;
C. Fingers;
D. Parallel edges on longitudinally spaced fingers, and
E. Did not facilitate positioning and removing of wires between fingers.

This evidence included the testimony of Mr. Taylor, of Mr. Pollock, the developer of the Taylor duct, and of Mr. Zigler Defendant's expert witness.

Functions and Results.

This evidence also established that the Taylor duct did not have the combination of all and, in fact, was lacking in two of the four necessary and desirable functions and results of the Walch invention, set forth on page A14 by the District Court in its decision (Pet. for Cert. Appx. C):

A. Ease of wire insertion and ease of intentional wire removal, even with the wires connected at both ends, and

B. Maximum useful area for bringing wires out of the duct.

Thus, not only was the District Court and the Court of Appeals warranted in finding that the Walch invention differed in structure, functions and results from the Taylor duct, but also in finding that applying the standard of invention as set out in *Graham* v. *John Deere*, these differences in structure, functions and results cumulatively were not obvious within the meaning of 35 U. S. C. 103.

As indicated by this Court in *Graham* v. *John Deere*, in considering the question of invention, Courts may take into account as secondary factors such factors as commercial success, long felt need for the invention, failure of others in the field to solve the problems solved by the inventions and immediate acceptance of the invention by those in the field. Uncontested evidence was received to establish the existence of each of these factors. The Courts below did not find it necessary to utilize these secondary factors to find the invention unobvious but were convinced of its unobviousness based on the primary tests of this Court's prior decisions.

It is also interesting to note that the District Court did not consider commercial success of the Walch invention as bearing on the issue of unobviousness, even though the

parties admitted the Walch invention had considerable commercial success. The Court only considered the relevancy of commercial success as it related to utility.

The Defendant bases Question No. I on a premise that is contrary to the evidence. Defendant contends "the Patent Office predicated patentability on the recitation (in Claim 5) of a restricted passage into the holes and not on the shape of the edges of the holes and where in each device above (the unadmitted, self-serving sketches on Pages 3 and 4 of the Petition) the purpose of the restricted passage . . . was to prevent wires from accidentally falling out of the holes". One need only to refer to the file histories of the Walch patent (Appx. I, pp. 5 to 68) and the Caveney patent application (Appx. III, p. 935 to Appx. IV, p. 1420) to see that the Patent Office did not predicate patentability on any such basis. That this premise is incorrect is also apparent from an examination of the testimony of Mr. Jeffers (Appx. VII, pp. 985 to 986) and Mr. Zigler (Appx. VII, pp. 684 to 696), the patent experts in the case.

It is submitted that Defendant is altering, ignoring and amending the facts in its presentation of Question No. I and that the facts in the Petition question are expressly contrary to the findings of fact as found by the District Court and affirmed on review by the Court of Appeals.

Clearly, the Courts below followed the mandates of this Court's prior decisions and Defendant simply does not like the outcome. There is no basis to warrant further review by this Court of Question No. I.

QUESTION NO. II.

In the first paragraph of the Petition under the heading, Question No. II, Defendant again asserts that the Patent Office predicated patentability on the recitation of a restricted passage into holes because it could not find this structure in the prior art. From the foregoing discussion under Question No. I, Plaintiff considers this statement to be questionable at best. As Plaintiff's expert witness testified, not one, but three patents were considered in the prosecution of the Walch and Caveney patent applications *by the Patent Office* and these patents each disclosed restricted wire receiving openings. The Patent Office Examiner took these patents into consideration in his draft of Claim 5.

Defendant next asserts that the only difference between the invention and the Taylor prior art was flat rather than rounded sides on the holes. This is contrary to the facts found by the Courts below (See the comparison chart made by the District Court between Claim 5 and Taylor, reproduced on pages 14 and 15 herein, and the Court's conclusion "Thus, of the seven elements mentioned, less than half are present in . . . Taylor . . .").

It is obvious from the foregoing discussion and argument that the Plaintiff did not fabricate an "afterthought" that the openings in its duct were "flat sided" rather than "round sided". The reader is requested to refer to Claim 5 reproduced on the back fold-out in the light of the Taylor prior art also shown on the fold-out.

It will be seen to be the fact as found by the Courts below that Taylor does not have "longitudinally spaced substantially parallel slits", "substantially parallel edges", "longitudinally spaced fingers", or narrowed "outer ends of the slits". From the *structural* standpoint, the claim in issue differs from the Taylor prior art in these respects.

The unobvious functions and results set forth hereinbefore also follow from the Plaintiff's structure. Walch, the inventor testified that, at the time he developed the invention, he contemplated all the structure, functions and results set forth above, thus, proving he contemplated the *full* invention before the patent application, maturing into the patent in suit, was even filed. Thus, the functions and results of the invention are included in the invention of the patent in suit and provide support for the language of Claim 5.

Defendant's disparagement of the Courts below is without merit, as can be seen from the careful treatment given this case by both Courts, and Defendant's "afterthought" arguments are without basis in fact or law.

QUESTION NO. III.

Question No. III is also based on the same false premises hereinbefore discussed. Additionally, Defendant asserts in effect that it was denied both substantive and procedural due process by the District Court's refusal to admit into evidence one of Plaintiff's catalogs for purposes of allegedly impeaching the testimony of one of Plaintiff's witnesses.

Defendant further asserts on Page 9 of its Petition that the *sole* ground on which the Court refused to allow Defendant to use this catalog was that this catalog had not been marked as an exhibit before Trial in accordance with the Pre-Trial Order.

This issue and statement is directly contrary to fact. The District Court's Pre-Trial Order (Appx. V p. 16) provided:

> "At the Pre-Trial Conference the Court will consider the following . . . (d) All exhibits. No exhibit shall be admitted at the Trial which has not been marked

for identification at the Pre-Trial *unless good cause has been shown such exhibit was not available at the Pre-Trial . . .*" (Emphasis added.)

The admissibility of the catalog was fully argued before the Court (Appx. VI, pp. 232 to 238) and the District Court pointed out that the Defendant had not shown *good cause* for the document to be admitted (Appx. VI, pp. 244 to 246).

This catalog, along with some other documents, was offered by Defendant regarding what it calls the "taut vs. slack" argument.

Such evidence was, as the District Court found, merely cumulative of other evidence before the Court and would add nothing to the facts already in evidence before the Court (Pet. for Cert. Appx. C pp. A26-27).

As a matter of fact, the *first* matter treated at the Trial was Defendant's motion to use similar documents. The District Court was furnished documents at that time and took this matter under advisement with the documents in the Court's possession during the entire Trial. During the Trial, extensive additional evidence was introduced into the record by both parties on the subject of wiring control panels, and Defendant liberally cross-examined Plaintiff's witnesses in this regard. Defendant's witnesses in its case-in-chief testified extensively as to how control panels were wired. Because this other evidence as to how control panel were wired was before the Court, the Court properly decided that these documents were merely cumulative and would add nothing to the facts already before the Court.

The issue of admissibility of such documents was also fully briefed by both parties at the trial before the District Court's decision, was treated in the appeal briefs and was treated in the decision of the United States Circuit Court

of Appeals for the Sixth Circuit (Pet. for Cert. Appx. A pp. A6 and A7). As the Court of Appeals said, it was "well satisfied that the District Court had before it sufficient documentary and testimonial evidence of the nature of wiring in electrical control panels. Not only did the District Court admit several catalogs of Panduit Corporation, Stahlin Bros., and Taylor Electric, all containing photographs of electrical control panels, but Messrs. Caveney and Luc were cross-examined extensively on the basis of several exhibits showing electrical control panels with slack wires in them."

Consequently, it cannot be said that substantive due process was denied Defendant with respect to this catalog.

Certainly, procedural due process was not denied the Defendant by the District Court's refusal to admit this catalog into evidence. Defendant failed to show *prejudice* as a result of the District Court's ruling in this regard or show *good cause* for its admission and, thus, the District Court did not abuse its discretion in refusing to admit this particular catalog into evidence.

QUESTION NO. IV.

Defendant states as its fourth issue that the District Court and the Court of Appeals both erroneously held that there was *contributory* infringement by the Defendant's Web-Slot duct. However, Judge Fox actually held that "The Plaintiff has met its burden of establishing that both the Lok-Slot and Web-Slot ducts manufactured by Defendant *directly* infringe Claim 5 of the valid patent No. 3,024,301". (Emphasis added) Thus, contrary to Defendant's assertion, the District Court did *not* affirmatively answer the question posed by Defendant on Page 9 of its Petition. The question of fact really is whether there was *evidence* of actual infringement on which Defendant can

be *found guilty* of infringement—under any sub-paragraph of 35 U. S. C. 271.

Under the Patent Statute 35 U. S. C. 282, the burden of proof is with the Plaintiff to prove infringement. Under the accepted rules of evidence, once a Plaintiff has established its prima facie case of infringement, the burden of proceeding with evidence to rebut this prima facie case of infringement then shifts to the Defendant. Defendant in this case did not offer any evidence during its case-in-chief to rebut the prima facie case of infringement by the Web-Slot duct, established by Plaintiff to infringe during its case-in-chief. As a matter of fact, the Court even clearly indicated, after the close of Plaintiff's case when Plaintiff moved for a directed verdict on the issue of infringement, that the Plaintiff had made out its prima facie case and that the burden of proceeding with the evidence had shifted to the Defendant:

> "THE COURT: Now there may be some importance to the distance between the base of the fingers and to the point of enlargement which I don't see at the present time. But I find *as a matter of fact* on Plaintiff's Exhibit A and the Web duct, which is—Plaintiff's Exhibit A—
>
> MR. PETHERBRIDGE: 30A.
>
> THE COURT: —30A, which is the product of the Defendant, and the Web duct, which is Plaintiff's Exhibit 17, that it embraces every one of the teaching of the Walch patent; that the snipping of the web was contained in the Defendant's advertising catalog, which is Plaintiff's Exhibit 11B, on the back side of that Exhibit, the very top; once the operator snips the web it is as the product in Plaintiff's Exhibit 30A insofar as that particular area is concerned, the area which is designed to contain the wires.
>
> For the purposes of this case *at this point*, I find infringement.

MR. SIMPSON: Your Honor, might I just say something here in connection with the Web-Slot. As a matter of fact, I think if your Honor will recall, there has not been one shred of testimony to the effect that one of these webs has ever been snipped. They have a very substantial use as they are manufactured.

Mr. Caveney, the President of Plaintiff corporation, himself indicated that the elements of Claim 5 of Walch are not found in the Web-Slot Duct as it is manufactured. All we have before us is an indication that at some time Mr. Stahlin testified, it was in the past, it is not now. There was an illustration in one brochure which you have before you here as to how a web might be snipped. But there is no testimony that it's ever been snipped, that there has ever been in fact infringement. . . .

THE COURT: *Excepting I asked Mr. Stahlin what he meant by obvious, that it was obvious to any operator that all he had to do was snip the web and you have the product. And that therefore there was no need for the instructions any more.*

MR. SIMPSON: Defendant, your Honor, does not manufacture an infringing product in the sense that it is a snipped product, if we assume for the purpose of this discussion that a Lok-Slot constitutes an infringement. It manufactures a Web-Slot duct, and there is no evidence there has been any infringement.

THE COURT: For the purpose of a decision *at this time*, that's my decision. *We go forward.*

MR. SIMPSON: *Is this the final order?*

THE COURT: *This is not a final order.* We are in trial, *and we are proceeding to the conclusion of the trial*, all right." (Emphasis added.)

Even after this colloquy, the Defendant did not introduce any evidence on this matter.

The actual evidence of infringement adduced at the trial by Plaintiff included the examination of Mr. Stahlin, Presi-

dent of Defendant (Appx. VI, pp. 339 to 342), documentary evidence (Pl. Exh. 11B; Appx. II, p. 453), Answers to Plaintiff's Interrogatories 33 and 35 and the testimony brought out *by the Court* alluded to in the above quotation regarding Defendant's brochure, PX11B, during presentation of Plaintiff's case-in-chief:

"Q. Do your customers cut the web on the Web-Slot duct in order to lay wires into the slot?

A. I presume. *I have seen it cut.*

Q. Do you instruct them how to do that?

A. We did at one time, we don't now.

Q. I refer you to Plaintiff's Exhibit 11B that you have in front of you. On the back side thereof you will find the statement—

A. Yes.

Q. 'Similar to the Lok-Slot style, the Web-Slot raceway has a narrow strip or web of material enclosing each opening.'

A. We did in February Fifty-eight.

Q. 'To insert wires, the workman has only to snip the web and slide the wires into place . . .'

A. Correct.

Q. On the left there is a photograph showing where he snipped out the web in some of the slots.

A. Correct.

Q. That's intended and in fact shows the use to which the Web-Slot is put?

A. In Fifty-eight.

Q. It isn't put to that use today?

A. I don't think so.

Q. Do you go out in the field and watch people install your duct in electrical control panels?

A. I?

Q. Yes.

A. Very seldom.

Q. Well, you told me on your deposition that you do issue instructions to your customers with regard to cutting the web.

A. We did in Fifty-eight.

Q. Do your sales people do it?

A. I don't think it's necessary today. It is not in our literature today."

(Unrelated portion omitted.)

"THE COURT: After (*sic*, About) that Web-Slot before us in your instruction: 'To insert wires, the workman has to snip the web and slide the wires into place.'

THE WITNESS: Yes, this web here.

THE COURT: Then you say it isn't necessary anymore?

THE WITNESS: Well, they find that they pull right through these holes.

Q. Thread them through?

A. Thread them through. But, you see, the same die makes both. It's easier to do that. They just pull the—the gate to the die is changed, and they just—

THE COURT: Would it be obvious to the workman all he is to do is snip this?

THE WITNESS: Yes."

Certainly, sufficient evidence of direct infringement by the Web-Slot duct was before the District Court to support its finding of fact that infringement existed. Moreover, the issue of infringement of the Web-Slot duct was treated in detail by both parties at the trial, in closing arguments, and was fully briefed by both parties as a separate issue and considered by the District Court in its decision (Pet. for Cert. Appx. C p. A35). The finding of fact of the District Court on this issue, therefore, was no oversight on the part of either the parties or the District Court. Indeed, the Court of Appeals was so convinced of the correctness of the District Court decision of this issue under the "clearly erroneous" doctrine that it categorically affirmed the District Court on this issue of infringement "for reasons stated in the Opinion of the District Court, which we shall not repeat".

Since the District Court found that there was sufficient evidence to support its finding of fact of direct infringement, the argument of Question No. IV of Defendant's Petition relating to contributory infringement and inducement to infringe and the application of the *Aro Mfg. Co.* case are both inapropos and moot insofar as a valid ground for a Petition for a Writ of Certiorari is concerned.

CONCLUSION.

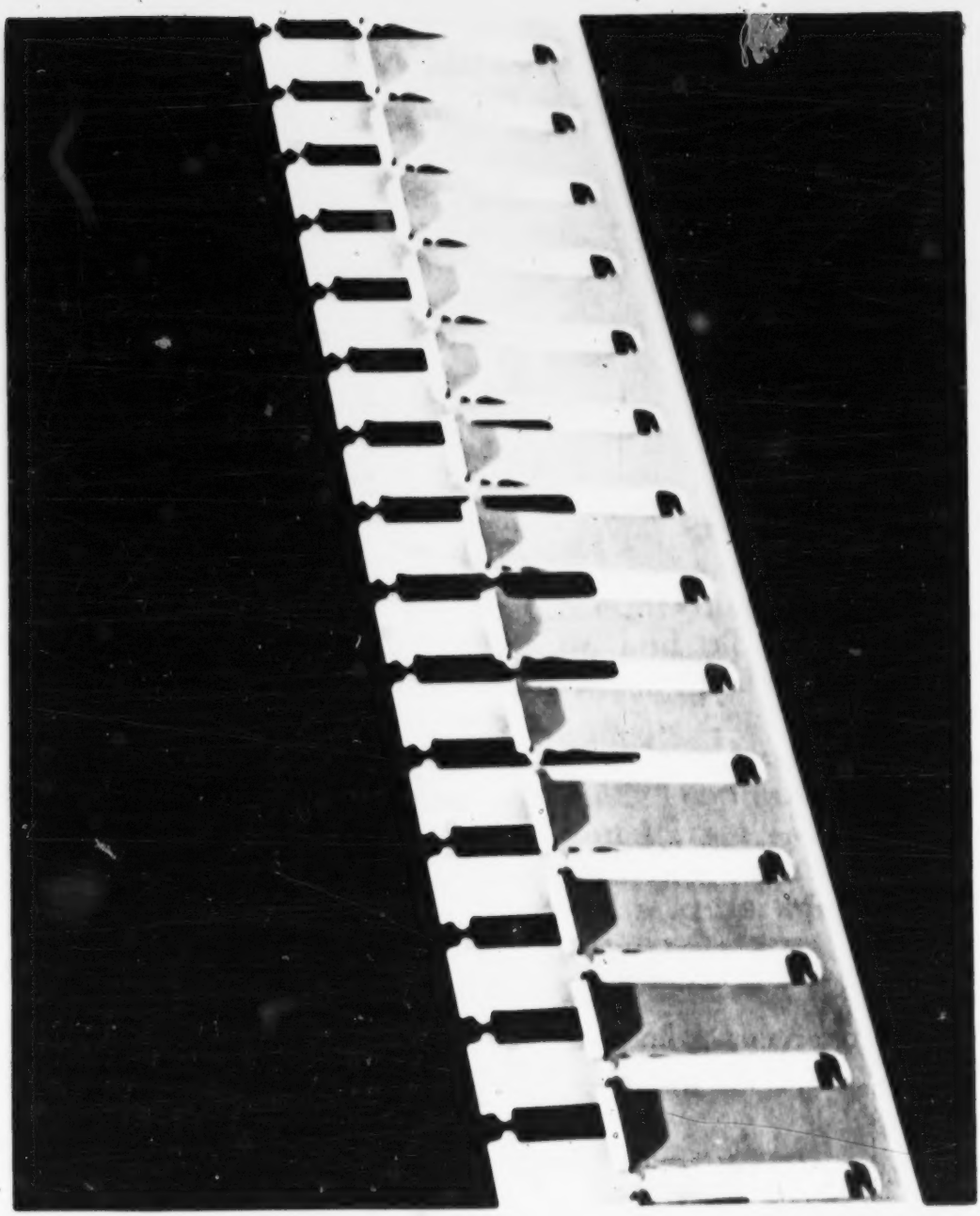
For the foregoing reasons and because there has been no question presented in this Petition to warrant the grant of Certiorari, it is requested that the Petition for a Writ of Certiorari be denied. Basically, only questions of fact are involved and there are no special and important reasons to grant the Writ, since both Courts below carefully followed the applicable decisions of this Court.

Respectfully submitted,

ROY E. PETHERBRIDGE,
JOHN M. O'NEILL,
Attorneys for Respondent.

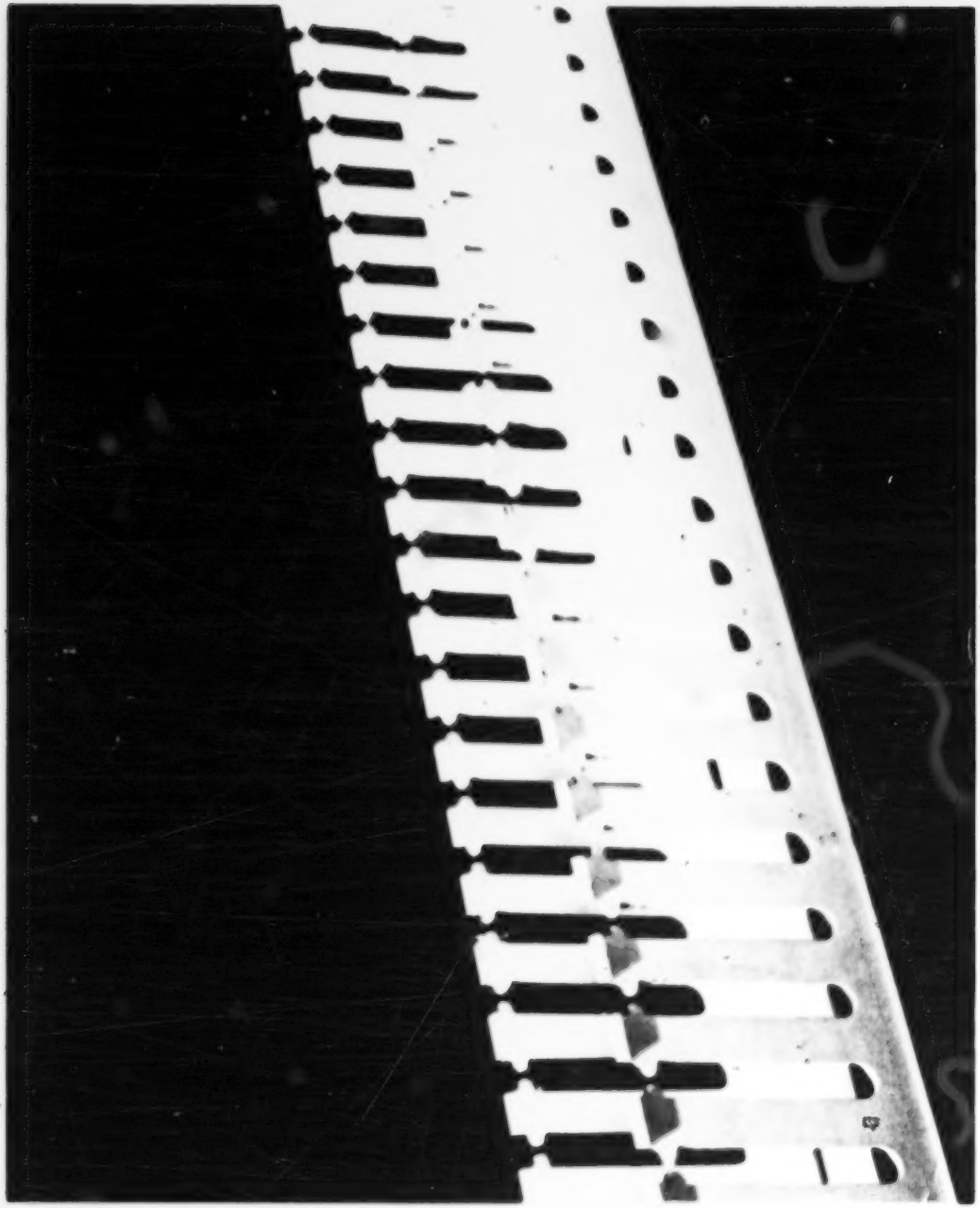
PLAINTIFF'S EXHIBIT 44.

Commercial Panduit Duct.



PLAINTIFF'S EXHIBIT 57.

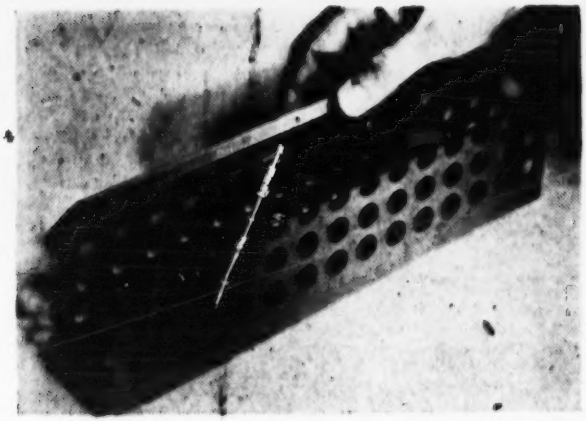
Defendant's Infringing Lok-Slot Duct.



DEFENDANT'S EXHIBIT 26.

Taylor Publication.

PLASTIC WIRING DUCT— Eliminates Lacing



To hold, protect, and distribute a harness, a convenient Wiring Duct has important time-and-labor-saving advantages.

Made from a thermoplastic material, its chemical and physical properties are similar to those of machine tool wire insulation. Cover snaps on and off. Clips, inserted at regular intervals, hold wires firmly and eliminate costly lacing of harness.

The duct will not support combustion, will not warp under damp or moist conditions. Lengths range up to 45", widths from 1" to 4"—holding from 30 to 150 14ga, 19-strand machine tool wires. Lengths are easily cut with a knife. Manufacturer:

TAYLOR ELECTRIC, INC., Dept. EE,
15460 Dale, Detroit 23, Mich.

For more data, Write EE 2697 on inquiry card enclosed

(Electrical Equipment Magazine, May, 1954.)